

No. 11652

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United States  
Circuit Court of Appeals  
For the Ninth Circuit

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LE ROY J. LEISHMAN,

Appellant,

vs.

RADIO CONDENSER COMPANY and GENERAL  
INSTRUMENT CORPORATION,

Appellees.

RADIO CONDENSER COMPANY and GENERAL  
INSTRUMENT CORPORATION,

Appellants,

vs.

LE ROY J. LEISHMAN,

Appellee.

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Transcript of Record  
In Two Volumes  
VOLUME I  
Pages 1 to 166

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Upon Appeals from the District Court of the United States  
for the Southern District of California,  
Central Division



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Central Division





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[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in italic; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in italic the two words between which the omission seems to occur.]

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## NAMES AND ADDRESSES OF ATTORNEYS

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LEONARD S. LYON,  
LEONARD S. LYON, JR.  
811 West Seventh Street,  
Los Angeles 14, Calif. [1\*]

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\* Page numbering appearing at foot of page of original certified Transcript of Record.



In the United States District Court, Southern  
District of California, Central Division

Civil Action No. 4395BH

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,  
Plaintiffs,

vs.

LEROY J. LEISHMAN,

Defendant.

COMPLAINT—DECLARATORY JUDGMENT  
SUIT ON LEISHMAN REISSUE PATENT  
No. RE 20,827

1. Plaintiff, Radio Condenser Company, is a New Jersey corporation having its principal place of business at Thorne and Copewood Streets, in the City and County of Camden and State of New Jersey;

Plaintiff, General Instrument Corporation, is a New Jersey corporation having its principal place of business at 829 Newark Avenue, in the City of Elizabeth and State of New Jersey;

Defendant, Leroy J. Leishman, is a citizen of the State of California, and resides in the City of Los Angeles, California; [2]

The jurisdiction of this Court arises out of the fact that the parties are citizens of different states, and that the amount in controversy is in excess of Three Thousand Dollars (\$3000.00) exclusive of



interest and costs. The jurisdiction of this Court also depends upon the patent laws of the United States.

2. This action is brought under Section 274-D of the Judicial Code, 28 U.S.C. § 400, because there is an actual controversy now existing between the parties, in respect of which plaintiffs need a declaration of their rights by this Court.

3. Plaintiff, Radio Condenser Company, is a manufacturer of radio condensers and tuners which, prior to the effective prohibition date of the Government Order prohibiting production, etc., effective April 22, 1942, were sold to radio set manufacturers throughout the United States and which condensers and tuners were then installed or embodied by such radio set manufacturers in radio sets then sold by them to distributors throughout the United States.

Plaintiff, General Instrument Corporation, is also a manufacturer of radio condensers and tuners which, prior to the effective prohibition date of the Government Order prohibiting production, etc., effective April 22, 1942, were sold to radio set manufacturers throughout the United States and which condensers and tuners were then installed or embodied by such radio set manufacturers in radio sets then sold by them to distributors throughout the United States. One of such radio set manufacturers then serviced by each of the plaintiffs was Galvin Manufacturing Corporation of Chicago, Illinois, a corporation of Illinois, which purchased radio condensers and tuners from each of the plaintiffs [3]

and installed or embodied the same in radio receiving sets which it then manufactured and sold to distributors. One of such distributors was The Richards and Conover Company, a corporation of Missouri, having a place of business in the City of Oklahoma City, State of Oklahoma.

4. This action arises out of a controversy over the questions of validity and infringement of United States Reissue Patent No. Re. 20,827 of the defendant, LeRoy J. Leishman, granted August 16, 1938, on a "Means and Method for Turning Rotatable Objects to Predetermined Positions." On or about March, 1945, the defendant, LeRoy J. Leishman, filed a complaint for alleged infringement of said Reissue Letters Patent No. Re. 20,827 in a suit against the aforesaid distributor, The Richards and Conover Company, in the United States District Court for the Western District of Oklahoma, Civil Action No. 2155, charging infringement of said Reissue Letters Patent No. Re. 20,827 of August 16, 1938, and particularly of claims 7, 8, 9, 10 and 11 of said Reissue Letters Patent, by reason of the selling or causing to be sold or using or causing to be used by the said The Richards and Conover Company, within said suit District, of certain radio receiving sets, referred to in the complaint of said suit as "Motorola sets, of which Models 25F, 26C, 26C-7, 27D, 20-O, 30-P, 29-B, 29B-6 \* \* \* are typical examples." Said Motorola radio receiving sets were manufactured by the said Galvin Manufacturing Corporation of Illinois and sold to the said The Richards and Conover Company. The aforesaid

recited Motorola radio receiving sets embodied or had installed therein radio condensers and tuners known as Radio Condenser Company Model 28 condensers, which were manufactured by the plaintiff, Radio Condenser Company, and which were sold by it to the said Galvin Manufacturing Corporation. A [4] photostatic copy of drawings of such Model 28 condenser as embodied in said recited Motorola sets is appended hereto and made part hereof and marked "Exhibit 1," and a specimen of such Model 28 condenser is submitted herewith and marked "Exhibit 2."

5. On or about December 15, 1938, the defendant gave notice to the plaintiff, Radio Condenser Company, of its alleged infringement of said Reissue Letters Patent No. Re. 20,827 because of its then manufacture and sale of its aforesaid radio condensers and tuners; and on or about May 11, 1939, plaintiff, Radio Condenser Company, in reply, denied that it was infringing any valid claim of defendant's said Letters Patent. On or about September 7, 1938, the defendant gave notice to the plaintiff, General Instrument Corporation, of the latter's alleged infringement of said Reissue Letters Patent No. Re. 20,827, because of its then manufacture and sale of radio condensers and tuners, which in all substantial and material respects, were the same as the Radio Condenser Company's aforesaid condensers and tuners; and on or about December 5, 1938, the plaintiff, General Instrument Corporation, in reply, denied that it was infringing any valid claim of defendant's said Letters Patent. The condensers and

tuners which were manufactured and sold by the plaintiff, General Instrument Corporation, which were known as General Instrument Corporation Model 31 tuners, were, in all material respects, substantially the same as said Radio Condenser Company's Model 28 condensers. A photostatic copy of drawings of such Model 31 tuners is appended hereto and made part hereof and marked "Exhibit 3," and a specimen of such Model 31 tuner is submitted herewith and marked "Exhibit 4." Plaintiff, Radio Condenser Company, as aforesaid, sold its said Model 28 condensers to the Galvin Manufacturing Company; and the plaintiff, General Instrument Corporation, similarly sold its Model 31 tuners to the said Galvin Manufacturing Company. [5]

6. Reissue Letters Patent No. Re. 20,827 was granted as aforesaid on August 16, 1938, said patent being a reissue of original Letters Patent No. 2,108,538 granted February 15, 1938. Said original Patent No. 2,108,538 was granted on an application filed June 19, 1937, Serial No. 149,245, said to be a division of an original application filed December 15, 1934, Serial No. 757,644. The defendant, LeRoy J. Leishman, was the owner of said original Letters Patent No. 2,108,538 and, since the date when said Reissue Letters Patent No. Re. 20,827 was granted, has been and still is the owner of said Reissue Letters Patent. On or about January 16, 1939, the said defendant, LeRoy J. Leishman, disclaimed claim 5 of said Reissue Letters Patent No. Re. 20,827.



7. On or about January 31, 1941, in the case of *Leishman v. Associated Wholesale Electric Co.*, a case tried in this District Court, and involving a push-button type of radio tuner manufactured by The Crosley Corporation of Cincinnati, Ohio, the said Reissue Letters Patent No. Re. 20,827, and particularly the said claims 7, 8, 9, 10 and 11, were held invalid by this District Court (the Honorable Judge Harrison) and reported in 36 F. Supp. 804; and on August 11, 1943, in an appeal taken by the said *Leishman* from the said decision, the said Reissue Letters Patent No. Re. 20,827, and particularly claims 7, 8, 9, 10 and 11 thereof, were held not infringed by the said push-button type of radio tuner manufactured by the said Crosley Corporation, in a decision rendered by the Circuit Court of Appeals for the Ninth Circuit, dated August 11, 1943, and reported in 137 F. (2d) 722. The said Crosley push-button type of radio tuner involved in said case of *Leishman v. Associated Wholesale Electric Co.* is shown in a drawing Exhibit A prepared and used by said *Leishman* in said case, a photostatic copy of which is appended hereto and [6] made part hereof and of which the marking "Exhibit A" is retained.

8. Plaintiffs aver that the said Reissue Letters Patent No. Re. 20,827 of August 16, 1938, were not infringed by any radio condensers and tuners manufactured and sold by them or each of them. Plaintiff, Radio Condenser Company, avers that the said Reissue Letters Patent No. Re. 20,827 were not in-

fringed by its claims 7, 8, 9, 10 and 11, as charged by the present defendant in his said complaint in the suit against the Richards and Conover Company filed as aforesaid in the District Court for the Western District of Oklahoma, by the sale or use of any Motorola radio receiving sets complained of in said suit in which were embodied or installed said Radio Condenser Company Model 28 radio condensers and tuners which were, as aforesaid, manufactured by the plaintiff, Radio Condenser Company, and sold by it to the Galvin Manufacturing Corporation and resold by Galvin Manufacturing Corporation to The Richards and Conover Company as aforesaid. Plaintiff, General Instrument Corporation, avers that the said Reissue Letters Patent No. Re. 20,827 were similarly not infringed by its manufacture and sale of its Model 31 tuners.

9. Plaintiffs believe and therefore aver that the said Reissue Letters Patent No. Re. 20,827 of August 16, 1938, and particularly as to said claims 7, 8, 9, 10 and 11, is invalid and void on the following grounds:

(a) Because the alleged invention or discovery described and claimed in said Reissue Letters Patent No. Re. 20,827, and all material and substantial parts thereof had been, prior to the alleged invention or discovery thereof by the said LeRoy J. Leishman, or more than two years before the date of his original [7] application for a patent therefor, pat-

ented or described or shown in the following Letters Patent of the United States and foreign countries:

United States Patents:

Patent No.	Date	Inventor
290,894	December 25, 1883.....	Kettel
368,689	August 23, 1887.....	Seales
585,996	July 6, 1897.....	Woodbridge
1,687,420	October 9, 1928.....	Bast
1,704,754	March 12, 1929.....	Marvin
1,906,106	April 25, 1933.....	Schaefer
1,930,192	October 10, 1933.....	Cunningham
1,948,373	February 20, 1934.....	Flaherty
2,014,358	September 10, 1935.....	Miller
2,072,897	March 9, 1937.....	Marschalk

British Patent:

405,716	February 15, 1934.....	Freytag
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and also other Letters Patent of the United States and foreign countries unknown to the plaintiffs at this time but which when known the plaintiffs pray leave to insert by proper amendment in the complaint.

(b) Because the alleged invention purported to be patented by said Reissue Letters Patent No. Re. 20,827 did not constitute or contain patentable novelty or patentable invention within the meaning of the patent laws, in view of what was common knowledge and in view of the state of the art as it existed prior to the alleged invention or discovery of said alleged invention or discovery of said alleged invention by the applicant, LeRoy J. Leishman, for said Reissue Letters Patent, or more than two years prior to his application [8] for the original Letters Patent therefor, which state of the art is evidenced by the United States and foreign Letters Patent

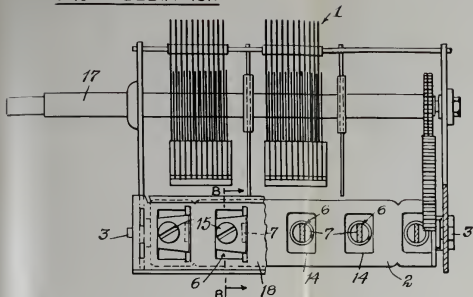




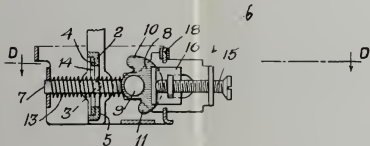
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## FRONT ELEVATION

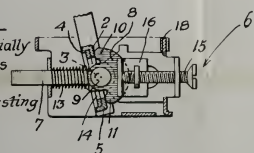


## SECTION B-B

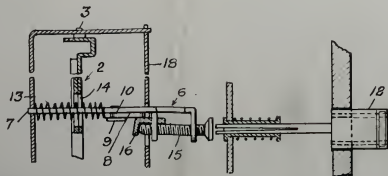


## SECTION C-C

Taken on substantially the same plane as section B-B, but illustrating adjusting operation



## SECTION D-D



RADIO CONDENSER COMPANY  
CONDENSER AND TUNER  
MODEL 28

- 1 - Radio apparatus tuning condenser
- 2 - Rotatable rocker mounted upon a shaft 3 and operatively connected with tuning condenser 1
- 4, 5 - Arms or shoulders of rotatable rocker 2, each extending on a different side of shaft 3
- 6 - Plungers for rocker 2, including bar 7
- 8 - Tappet movable about a pivot 9 carried by bar 7, having two ends 10 and 11, one of which engages one of the arms 4, 5 of rocker 2, when bar 7 is pushed inwardly or toward the left (See B-B) by means of push button 12. Bar 7 passes through rocker 2, and through recess 14 in the rocker
- 13 - Spring for plunger 6.

In section C-C, when plunger 6 is pushed to the limit of its movement, pivot 9 is substantially coaxial with rocker 2.

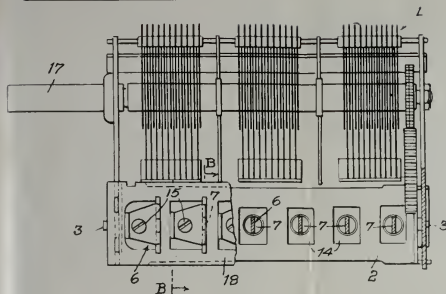
- 15 - Screw for holding tappet 8 in adjusted position by the aid of clamp 16

A plurality of plungers 6 is provided for rotating shaft 17 of tuning condenser 1 to a predetermined position, by any one of said plungers 6

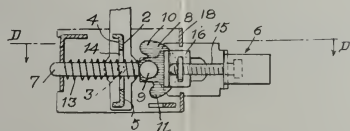
- 16 - Cover panel for the mechanism, through which screws 15 extend.



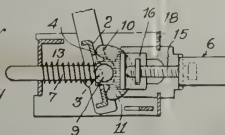
# FRONT ELEVATION



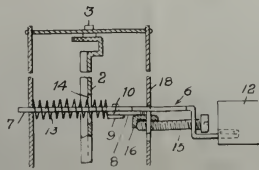
## SECTION B-B



SECTION C-C  
 When on Substantially  
 the same plane as  
 section B-B but  
 illustrating adjusting  
 operation



## SECTION D-D



EXHIBIT

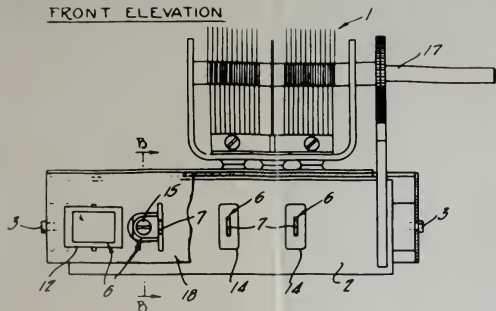
GENERAL INSTRUMENT CORPORATION  
 CONDENSER AND TUNER  
 MODEL 31

- 1 - Radio apparatus tuning condenser
  - 2 - Rotatable rocker mounted upon a shaft 3 and operatively connected with tuning condenser 1
  - 4, 5 - Arms or shoulders of rotatable rocker 2, each extending on a different side of shaft 3
  - 6 - Plungers for rocker 2, including bar 7
  - 8 - Tappet movable about a pivot 9 carried by bar 7, having two ends 10 and 11, one of which engages one of the arms 4, 5 of rocker 2, when bar 7 is pushed inwardly or toward the left (See B-B) by means of push button 12. Bar 7 passes through rocker 2, and through recess 14 in the rocker
  - 13 - Spring for plunger 6.
- In section C-C, when plunger 6 is pushed to the limit of its movement, pivot 9 is substantially coaxial with rocker 2.
- 15 - Screw for holding tappet 8 in adjusted position by the aid of clasp 16
- A plurality of plungers 6 is provided for rotating shaft 17 of tuning condenser 1 to a predetermined position, by any one of said plungers 6
- 16 - Cover panel for the mechanism, through which screws 15 extend.

GENERAL INSTRUMENT CORPORATION, CONDENSER AND TUNER  
 Model 31



FRONT ELEVATION



1 - Radio apparatus tuning condenser

2 - Rotatable rocker mounted upon a shaft 3 and operatively connected with tuning condenser 1

4, 5 - Arms or shoulders of rotatable rocker 2, each extending on a different side of shaft 3

6 - Manually movable operating means for rocker 2, including bar 7,

8 - Positioning element in the form of a means adjustably movable about a pivot 9 carried by bar 7, this means having two ends 10 and 11, one of which engages one of the arms 4, 5 of rocker 2, when bar 7 is pushed inwardly or toward the left (See B-B) by means of push button 12. Bar 7 passes through rocker 2.

13 - Spring holding operating means 6 in the inoperative position of Sec B-B.

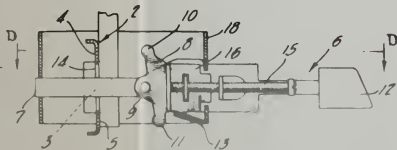
In section C-C, when operating means 6 is pushed to the limit of its movement, pivot 9 is substantially coaxial with rocker 2, there being a recess 14 in rocker 2 between arms 4, 5 to make this possible.

15 - Screw, operable from the external end of member 6 for holding positioning element 8 in adjusted position by the aid of clamp 16

A plurality of operating means 6 is provided for rotating shaft 17 of tuning condenser 1 to a predetermined position, by any one of said means 6

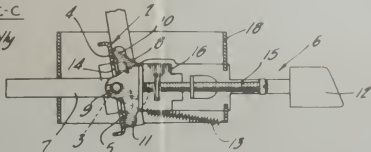
18 Cover panel for the mechanism, through which screws 15 extend.

SECTION B-B

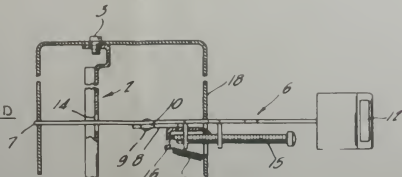


SECTION C-C

Taken on substantially the same plane as section B-B, but illustrating adjusting operation



SECTION D-D



[Endowed]: Filed  
April 20, 1945.





[Title of District Court and Cause.]

DEFENDANT'S ANSWER AND COUNTER  
CLAIM

To the Honorable the Judges of the District Court  
of the United States in and for the Southern  
District of California:

Defendant, for answer to Plaintiffs' Complaint  
in the above entitled cause, says:

I.

Defendant admits the allegations of Paragraphs 1,  
3, 5 and 6 of the complaint.

II.

Defendant denies the allegations of paragraphs  
2, 4, and 8, as well as each and every allegation of  
Paragraph 9. [14]

III.

Defendant denies the allegations of Paragraph 7  
of the complaint 1) because the holding of inval-  
idity by this District Court was deleted from the  
judgment by the Ninth Circuit Court of Appeals,  
and there is thus no decision of invalidity against  
the patent; and 2) because the Ninth Circuit Court  
of Appeals did not definitely say that the patent was  
not infringed by the radio tuner manufactured by  
the Crosley Corporation, but merely made a condi-  
tional statement as to infringement.

IV.

Defendant further denies that there is any basis  
for declaratory relief in favor of the plaintiffs.

## Counter Claim of Defendant

The defendant complains of the plaintiffs and alleges:

## I. Infringement

That both of the plaintiffs have, within the last six years and prior to the filing of this bill of complaint, and subsequent to the date of granting of reissue Letters Patent No. Re. 20,827, infringed claims 7, 8, 9, 10 and 11 thereof; and the plaintiffs threaten to continue so to infringe by making or causing to be made, or selling or causing to be sold, or using or causing to be used within this district and elsewhere within the United States, automatic tuning mechanisms embodying the inventions disclosed and claimed in defendant's said reissue Letters Patent, wilfully and without the consent of the defendant.

## II. Damages

That the plaintiffs have derived unlawful gains and profits [15] from such infringement which defendant would otherwise have received but for such infringement, and has thereby been caused irreparable damages.

Defendant Therefore Prays:

1. For a judgment from this Court that claims 7, 8, 9, 10 and 11 of United States Letters Patent No. Re. 20,827 are valid.
2. For a decree from this Court that both of the plaintiffs have infringed claims 7 to 11, inclusive, of the said reissue patent.

3. For a preliminary as well as a permanent injunction restraining the plaintiffs, their officers, agents, servants and employees from directly or indirectly making or causing to be made, selling or causing to be sold, or using or causing to be used, any automatic tuning mechanism embodying the inventions claimed in the said reissue Letters Patent No. Re. 20,827, or from infringing upon or violating the said Letters Patent in any way whatsoever.

4. For the costs and an accounting of profits and damages.

5. For a dismissal of the complaint on the ground that no proper basis for declaratory relief exists.

6. For such other and further relief as the Court may deem meet and just.

/s/ LEROY J. LEISHMAN,  
Defendant.

[Endorsed]: Filed Nov. 16, 1945. [16]

[Title of District Court and Cause.]

PLAINTIFFS' REPLY TO DEFENDANTS'  
COUNTERCLAIM

Now comes the plaintiffs and in reply to the Counterclaim filed by defendant allege as follows:

I.

In reply to Paragraph I of said counterclaim, plaintiffs specifically deny each and every allegation thereof.

II.

In reply to Paragraph II of said counterclaim, plaintiffs specifically deny each and every allegation thereof.

For further and affirmative defenses, plaintiffs allege:

III.

Plaintiffs believe and therefore aver that the said Reissue Letters Patent No. Re.20,827 of August 16, 1938, and particularly as to said claims 7, 8, 9, 10 and 11, is invalid and void on the following grounds: [17]

(a) Because the alleged invention or discovery described and claimed in said Reissue Letters Patent No. Re.20,827, and all material and substantial parts thereof had been, prior to the alleged invention or discovery thereof by the said LeRoy J. Leishman, or more than two years before the date of his original application for a patent therefor, patented or described or shown in the following

Letters Patent of the United States and foreign countries:

United States Patents:

Patent No.	Date	Inventor
290,894	December 25, 1883.....	Kettel
368,689	August 23, 1887.....	Seales
585,996	July 6, 1897.....	Woodbridge
1,687,420	October 9, 1928.....	Bast
1,704,754	March 12, 1929.....	Marvin
1,906,106	April 25, 1933.....	Schaefer
1,930,192	October 10, 1933.....	Cunningham
1,948,373	February 20, 1934.....	Flaherty
2,014,358	September 10, 1935.....	Miller
2,072,897	March 9, 1937.....	Marschalk

British Patent:

405,716	February 15, 1934.....	Freytag
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and also other Letters Patent of the United States and foreign countries unknown to the plaintiffs at this time but which when known the plaintiffs pray leave to insert by proper amendment in the answer to the counterclaim.

(b) Because the alleged invention purported to be patented by said Reissue Letters Patent No. Re. 20,827 did not constitute or contain patentable novelty or patentable invention within the meaning of the patent laws, in view of what was common knowledge and in view of the state of the art as it existed prior to the alleged invention or discovery of said alleged invention by the applicant, LeRoy J. Leishman, for said Reissue Letters Patent, or more than two years prior to his application for the original Letters Patent therefor, which state of the art is evidenced by the United States and



foreign Letters Patent set forth in clause (a) hereof and by such other parts of the state of the art which the plaintiffs are ready to prove.

(c) Because the said Reissue Letters Patent No. Re.20,827 is for a different invention from that disclosed and claimed in the original Letters Patent No. 2,108,58 of which it is a reissue.

(d) Because the applicant, LeRoy J. Leishman, for said Reissue Letters Patent was not the first and/or original inventor or discoverer of the thing or things purported to be covered by said Reissue Letters Patent, or of any material or substantial part thereof, but the same thing or things, and all material and essential features, prior to the alleged invention or discovery thereof by Leishman, or for more than two years prior to the date of his original application for a patent therefor, had been invented by (if there be any patentable invention described and claimed in said Reissue Letters Patent) or known to and in public use by or on sale by the applicants for the United States Letters Patent set forth in Clause (a) of this paragraph, residing at the residence stated in said patents, at said places [19] of residences and elsewhere in the United States, and by others whose names and addresses, together with the place of knowledge, use or sale, when ascertained, plaintiffs pray leave to insert by amendment or otherwise.

Wherefore, plaintiffs pray that defendant's Counterclaim be dismissed and that said defendant take nothing thereunder and that these plaintiffs

have such further and additional relief as the Court may deem fit and just, including plaintiffs' costs.

RADIO CONDENSER  
COMPANY and  
GENERAL INSTRUMENT  
CORPORATION,

By LYON & LYON,  
/s/ LEONARD S. LYON,  
Attorneys for Plaintiffs.

[Endorsed]: Filed Nov. 30, 1945. [20]

---

[Title of District Court and Cause.]

INTERROGATORIES PROPOUNDED  
BY THE DEFENDANT

I.

Now comes the defendant after filing a counter-claim and an answer to the complaint, and files the following interrogatories to the plaintiff General Instrument Corporation, to be answered by an officer of the said plaintiff competent to testify on its behalf:

\* \* \* \* \*

4. How many automatic tuners or actuators have you sold since November 16, 1939, that employed rockers and tappets constructed and arranged to be substantially coaxial when the plunger had reached the limit of its movement?

5. How many automatic tuners or actuators did you sell between February 15, 1938, and November 16, 1939, that employed rockers and tappets constructed and arranged to be coaxial when the plunger had reached the end of its movement?

6. How many automatic tuners or actuators have you sold since February 15, 1938, that did not employ rockers and tappets constructed and arranged to be coaxial when the plunger had reached the end of its movement?

7. How many automatic tuners or actuators of the general type shown in Plaintiffs' Exhibit 3 have you sold since February 23, 1943?

\* \* \* \* \*

9. Furnish accurate drawings and a sample of each type automatic tuner or actuator made since February 15, 1938?

10. How many of each type referred to in Interrogatory 9 did you sell between February 15, 1938, and November 16, 1939?

11. How many of each of the models referred to in Interrogatory 9 did you sell between November 16, 1939, and the date of your answer to this Interrogatory 11?

\* \* \* \* \*

17. How many automatic tuners or actuators have you sold to Wells-Gardner and Co., of Chicago, containing rockers and tappets constructed and arranged to be coaxial when the plunger had reached the limit of its movement?



18. How many automatic tuners or actuators have you sold to the Delco Radio Division of General Motors Corporation containing rockers and tappets constructed and arranged to be coaxial when the plunger had reached the limit of its movement?

\* \* \* \* \*

II.

Now comes the defendant after filing a counterclaim and an answer to the complaint, and files the following interrogatories to the plaintiff Radio Condenser Company, to be answered by an officer of the said plaintiff competent to testify in its behalf:

\* \* \* \* \*

4. How many automatic tuners or actuators have you sold since November 16, 1939, that employed rockers and tappets constructed and arranged to be substantially coaxial when the plunger had reached the limit of its movement?

5. How many automatic tuners or actuators did you sell between February 15, 1938, and November 16, 1939, that employed rockers and tappets constructed and arranged to be coaxial when the plunger had reached the end of its movement?

6. How many automatic tuners or actuators have you sold since February 15, 1938, that did not employ rockers and tappets constructed and arranged to be coaxial when the plunger had reached the end of its movement?

7. How many automatic tuners or actuators of the general type shown in Plaintiffs' Exhibit 3 have you sold since February 23, 1943?

\* \* \* \* \*

9. Furnish accurate drawings and a sample of each type automatic tuner or actuator made since February 15, 1938?

10. How many of each type referred to in Interrogatory 9 did you sell between February 15, 1938, and November 16, 1939?

11. How many of each of the models referred to in Interrogatory 9 did you sell between November 16, 1939, and the date of your answer to this Interrogatory 11?

\* \* \* \* \*

17. How many automatic tuners or actuators have you sold to Wells-Gardner and Co., of Chicago, containing rockers and tappets constructed and arranged to be coaxial when the plunger had reached the limit of its movement?

18. How many automatic tuners or actuators have you sold to the Delco Radio Division of General Motors Corporation containing rockers and tappets constructed and arranged to be coaxial when the plunger had reached the limit of its movement?

\* \* \* \* \*

/s/ LEROY J. LEISHMAN,

Defendant.

Dated, Los Angeles, California, December 7, 1945.

Received copy of the within this 7th day of December, 1945.

/s/ LEONARD S. LYON,

Attorneys for Plaintiffs.

[Endorsed]: Filed Dec. 7, 1945. [30]

[Title of District Court and Cause.]

PLAINTIFFS' OBJECTIONS TO  
DEFENDANT'S INTERROGATORIES

I.

Plaintiff, General Instrument Corporation, objects to Interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18 heretofore served on it by the defendant on the 7th day of December, 1945, on the grounds that the information called for is irrelevant to any issue in this case.

II.

Plaintiff, Radio Condenser Company, objects to Interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18 heretofore served on it by the defendant on the 7th day of December, 1945, on the grounds [31] that the information called for is irrelevant to any issue in this case.

LYON & LYON,  
/s/ LEONARD S. LYON,  
Attorneys for Plaintiff.

[Affidavit of service by mail.]

[Endorsed]: Filed Dec. 17, 1945. [32]

At a stated term, to wit: The September Term, A. D. 1945, of the District Court of the United States of America, within and for the Central Division of the Southern District of California, held at the Court Room thereof, in the City of Los Angeles, on Friday, the 18th day of January, in the year of our Lord one thousand nine hundred and forty-six.

Present: The Honorable Campbell T. Beaumont,  
District Judge

[Title of Cause.]

Plaintiffs' objections to defendant's interrogatories having been heard by the Court, pursuant to notice filed December 21, 1945, and counsel having argued the same, and the Court having duly considered the same and being fully advised as to the facts and the law, now sustains said objections.

[Title of District Court and Cause.]

MOTION OF PLAINTIFFS FOR  
SUMMARY JUDGMENT

Come now the Plaintiffs above named, Radio Condenser Company and General Instrument Corporation, and move this Honorable Court that summary judgment against Defendant herein and in favor of Plaintiffs be entered in the above entitled action, in accordance with Rule 56 of the Rules of Civil Procedure for the District Courts of the United States of America declaring that the tuning devices filed with the complaint in this case and marked Exhibits 2 and 4 do not infringe Claims 7, 8, 9, 10, or 11 of United States Reissue Letters Patent No. Re-20,827.

The grounds for this motion are:

1. Claims 7, 8, 9, 10, and 11 of Reissue Letters Patent No. Re-20,827 are limited to tuners having levers, "the cash register" type, and cannot include in their scope the Plaintiffs' [34] tuners which do not have levers; and

2. The United States Circuit Court of Appeals for the Ninth Circuit has heretofore held in *Leishman v. Associated Wholesale Electric Co.*, 137 F. (2d) 722, that tuners identical patentwise with Plaintiffs' tuners did not infringe Claims 7, 8, 9, 10, or 11 of Reissue Letters Patent No. Re-20,827 upon the ground that the said claims are restricted to tuners having levers.



This motion is based upon the pleadings and files of the above-entitled action; the admissions of defendant; the affidavit of Samuel S. Mackeown, attached to this motion as Exhibit B; the affidavit of Russell E. Cramer, attached to this motion as Exhibit C; a certified copy of the Bill of Complaint in the case of Leishman v. The Richards and Conover Co., attached to this motion as Exhibit D; a certified copy of Plaintiff's Response to Defendant's Motion for Bill of Particulars, in the case of Leishman v. The Richards and Conover Co., attached to this motion as Exhibit E; a certified File Wrapper and Contents in the matter of Re-issue Letters Patent No. Re-20,827 of LeRoy J. Leishman, attached to this motion as Exhibit F; a certified copy of the disclaimer to Claim 5 of Re-issue Letters Patent No. Re-20,827, attached to this motion as Exhibit G; and upon the showing upon the face of surrendered United States Letters Patent No. 2,108,538, a copy of which is attached to this motion as Exhibit H.

Dated this 23rd day of January, 1946.

/s/ LEONARD S. LYON,

/s/ LEONARD S. LYON, JR.,

Attorneys for Plaintiffs. [35]

EXHIBIT B

In the United States District Court  
Southern District of California  
Central Division

Civil Action No. 4395-BH

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,  
Plaintiffs,

vs.

LEROY J. LEISHMAN,

Defendant.

AFFIDAVIT OF SAMUEL S. MACKEOWN  
FILED IN BEHALF OF PLAINTIFFS

State of California,  
County of Los Angeles—ss.

Samuel S. Mackeown, being first duly sworn, deposes and says as follows:

He is a resident of Pasadena, California. He graduated from Cornell University in 1917, majoring in physics and chemistry. In 1917, he accepted a position with the National Bureau of Standards, in Washington, D. C. In 1918, he was appointed a Second Lieutenant in the Signal Corps of the United States Army and was assigned to the Radio Development Section, first at Camp Alfred Vail, and later at the office of the Chief Signal Officer, at Washington, D. C. In 1919 he returned to the Bureau of Standards as Assistant Physicist to con-

tinue work in the radio section. In the fall of 1919 he accepted a position as a Research Engineer with the Western Electric Company. In 1920, he returned to Cornell University as a graduate student and as instructor in physics and received the degree of Doctor of Philosophy, majoring in physics, in 1923. In the fall of 1923, he was awarded a National Research Fellowship in physics from the Rockefeller Foundation and was assigned to work at the California Institute of Technology. In 1926, he accepted a position on the permanent staff of the California Institute of Technology as Assistant Professor of physics and electrical engineering, and since that time he has been continuously in the employ of the California Institute of Technology as Assistant Professor, Associate Professor and Professor. Since 1926, he has been in charge of all of the work at the California Institute of Technology relating to radio communication, electronics, etc.

He testified on behalf of the defendant in the case before Judge Ben Harrison entitled "Leishman v. Associated Wholesale Electric Company," No. 1463-BH, reported in 36 Fed. Supp. 804. In that case certain radio tuning units and condensers manufactured by the Crosley Corporation were charged to infringe Claims 7 to 11, inclusive, of Reissue Letters Patent No. Re. 20,827, issued to LeRoy J. Leishman. He testified regarding the disclosure of Reissue Letters Patent No. Re. 20,827 and compared the Crosley tuning device with the structure shown in the patent.



He has been shown a radio tuning unit manufactured by the Radio Condenser Company and filed as Exhibit 2 to the Complaint in this action. He has also been shown a tuning unit manufactured by the General Instrument Corporation marked Exhibit 4 to the Complaint in this action. He has also been shown a copy of the Bill of Complaint, together with Exhibit 1, which is a [37] drawing of the Radio Condenser tuner Exhibit 2, and Exhibit 3, which is a drawing of the General Instrument tuner Exhibit 4, and Exhibit A. He recognizes Exhibit A as a drawing of the Crosley tuner which was the subject of the aforesaid suit of *Leishman v. Associated Wholesale Electric Company*.

He has made a careful comparison of the Radio Condenser tuner (Exhibits 1 and 2) and of the General Instrument tuner (Exhibits 3 and 4) with a radio tuner manufactured by the Crosley Corporation and shown in the drawing Exhibit A, which he recognizes to be the tuning unit charged to infringe Claims 7 to 11, inclusive, of Reissue Letters Patent No. Re. 20,827 in the *Leishman v. Associated Wholesale Electric Company* case.

Insofar as the subject matter of Reissue Letters Patent No. Re. 20,827 is concerned, these three tuning units (Exhibits 1 and 2, Exhibits 3 and 4, and the Crosley tuner Exhibit A) are identical. Each of these three units contains condensers 1 which are mechanically connected to a shaft 3 upon which is mounted a rocker 2. In each of these three units, the rocker 2 is adapted to coact with an ad-

justable tappet 8. In each of these three units, the adjustable tappet 8 may position the rocker 2 and thus tune the condensers 1 by the depressing of a plunger or push button 12, causing the tappet 8 to move in rectilinear motion. In each of these three units, the tappet 8 can be firmly locked into adjusted position by means of a wedging clamp 16 operated by a screw 15. The push buttons, rockers, tappets, and locking devices on each of these three units are substantially identical, operate in exactly the same manner, and perform exactly the same function; and each of these three units is made of substantially the same parts. One unimportant difference does exist between the Radio Condenser and General Instrument units and the Crosley unit. In the Crosley unit, the positioning member or tappet 8 is urged from coaction with the rocker 2 by a spring 13 in tension, whereas [38] in the Radio Condenser and General Instrument units the positioning member or tappet 8 is urged from coaction with the rocker 2 by a spring 13 in compression. This difference is immaterial and does not concern the functioning of the different tuners in the light of the teachings of Reissue Letters Patent No. Re. 20,827 and Claims 7 to 11 thereof.

Reissue Letters Patent No. Re. 20,827 discloses a tuner which tunes simultaneously two independent radio circuits, one to receive television and one to receive the associated sound. This tuner has two rockers 54 and 48 and two tappets 61 and 62. The Radio Condenser tuner (Exhibits 1 and 2), the General Instrument tuner (Exhibits 3 and 4), and

the Crosley unit (Exhibit A) are capable of tuning only one radio circuit and are not used in a television receiver. They are used only in a receiver for the ordinary radio station which broadcasts sound. None of these three units has any rocker corresponding to the rocker 54 of the Reissue Patent No. Re. 20,827 or any tappet corresponding to the tappet 62, or any parts which perform the function of the rocker 54 and the tappet 62 of the reissue patent.

Reissue Letters Patent No. Re. 20,827 discloses tuner which operates by manually depressing a lever similar to the lever used to operated the ordinary cash register. This lever operates to tune two radio circuits simultaneously. Neither the Crosley tuner nor the Radio Condenser tuner nor the General Instrument tuner use levers. All of these three tuners are operated by manually positioning push buttons or plungers. These push buttons or plungers perform only a part of the function of the levers of the reissue patent since these plungers can tune only one radio circuit and are incapable of tuning two associated radio circuits simultaneously. These plungers or push buttons do not operate in the same way or in substantially the same manner as do the levers of the Reissue Letters Patent No. Re. 20,827. [39]

Since the Radio Condenser tuner (Exhibits 1 and 2) and the General Instrument tuner (Exhibits 3 and 4) have substantially the same structure, operate in exactly the same way, and fulfil the same function as the Crosley tuner (Exhibit A), the same difference in structure, mode of operation, and

function which exist between the Crosley tuner and the tuner disclosed in Reissue Letters Patent No. Re. 20,827 also exist between the Radio Condenser tuner, the General Instrument tuner, and that disclosed in Reissue Letters Patent No. Re. 20,827.

/s/ SAMUEL S. MACKEOWN,  
Affiant.

Subscribed and sworn to before me this 22nd day of January, 1946.

[Seal] /s/ IRENE J. KNUDSEN,  
Notary Public in and for the County of Los Angeles, State of California. [40]

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EXHIBIT C

In the United States District Court, Southern  
District of California, Central Division

No. 4395-B Civil

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,  
Plaintiffs,

vs.

LEROY J. LEISHMAN,  
Defendant.

AFFIDAVIT OF RUSSEL E. CRAMER

State of New York,  
County of New York—ss.

Russell E. Cramer, being first duly sworn,  
hereby deposes and says as follows:



1. I am the Vice President of the plaintiff, Radio Condenser Company, and am fully conversant with the facts hereinbelow stated.

2. The Motorola radio receiving sets referred to in paragraph 4 of the complaint of the above-entitled cause, of which Models 25F, 26C, 26C-7, 27D, 28-O, 30-P, 29-B, 29B-6 referred to in said paragraph 4 of the complaint are typical examples, embodied [41] or had installed therein radio condensers and tuners manufactured by the plaintiff, Radio Condenser Company, and known as Radio Condenser Model 28 condensers. This Model 28 condenser as embodied in said recited Motorola sets is correctly shown in the photostatic copy of the drawing thereof annexed as "Exhibit 1" to the complaint in the above-entitled cause, and the specimen of such Model 28 condenser constituting "Exhibit 2" of the complaint is a correct specimen thereof.

RUSSELL E. CRAMER.

Subscribed and sworn to before me this 12th day of December, 1945.

[Seal] MARIE STIRISS,

Notary Public, New York County, N. Y. Co. Clk's  
No. 539, Reg. No. 1175-S-7.

Commission expires March 30, 1947. [42]

## EXHIBIT D

In the United States District Court for the  
Western District of Oklahoma

Civil Action No. 2155

LEROY J. LEISHMAN,

Plaintiff,

vs.

THE RICHARDS AND CONOVER COMPANY,  
a Corporation,

Defendant.

BILL OF COMPLAINT FOR INFRINGEMENT  
OF LETTERS PATENT

Plaintiff complains of the defendant and alleges:

I. Plaintiff

That the plaintiff is a citizen of the State of California and resides in the City of Los Angeles, California.

II. Defendant

That the defendant is a corporation organized under and existing by virtue of the laws of the State of Missouri, and has a regular established place of business in the City of Oklahoma City, State of Oklahoma.

III. Jurisdiction

(1) That the jurisdiction of this Court is based upon the Patent Laws of the United States of America.

(2) That the acts of infringement hereinafter complained of were and are being committed in the Western District of Oklahoma, and elsewhere within the United States. [43]

#### IV. Title to Patents

(1) On February 15, 1938, original United States Letters Patent No. 2,108,538, were duly and legally issued to plaintiff for an invention in "Means and Method for Turning Rotatable Objects to Predetermined Positions," and on August 16, 1938, said Letters Patent were surrendered, and were duly and legally reissued as reissue Letters Patent No. 20,827; and on or about January 16, 1939, the plaintiff disclaimed claim 5 of said reissue Letters Patent No. 20,827.

(2) Plaintiff, since the date of the issuance of said original Letters Patent and until said original Letters Patent were surrendered, has been the owner of said original Letters Patent, and plaintiff, since the date when said reissue Letters Patent were granted, has been and still is the owner of said reissue Letters Patent.

(3) On June 13, 1939, original Letters Patent No. 2,162,282 were duly and legally issued to plaintiff for an invention in Automatic Tuners.

(4) Plaintiff since the date of issuance of the original Letters Patent No. 2,162,282, has been the owner of said original Letters Patent.

#### V. Infringement

That defendant has, within the last six years and prior to the filing of this bill of complaint, and



subsequent to the dates of granting of said reissue Letters Patent and of said original Letters Patent No. 2,162,282, infringed claims 7, 8, 9, 10 and 11 of said reissue Letters Patent, and claims 7 and 11 of said original Letters Patent No. 2,162,282; and defendant threatens to continue so to infringe by selling or [44] causing to be sold, or using or causing to be used within this district and elsewhere within the United States, radio receiving sets known as Motorola sets, of which Models 25F, 26C, 26C-7, 27D, 28-O, 30-F, 29-B, 29B-6, 35N, 28-O, 9-24, 9-24A, 16C, 181O, 19-B are typical examples, made in accordance with and embodying the inventions disclosed and claimed in plaintiff's said reissue Letters Patent and said Letters Patent 2,162,282, wilfully and without the consent of the plaintiff.

## VI. Damage

That defendant has derived unlawful gains and profits from such infringement which plaintiff would otherwise have received but for such infringement, and has thereby been caused irreparable damages.

### Plaintiff Therefore Prays:

(1) For a preliminary as well as a permanent injunction restraining the defendant, its officers, agents, servants and employees from directly or indirectly making or causing to be made, selling or causing to be sold, or using or causing to be used, any means for turning rotatable objects to predetermined positions, made in accordance with or embodying the inventions of the said reissue United

States Letters Patent No. 20,827, or from infringing upon or violating the said Letters Patent in any way whatsoever; and restraining the defendants, its officers, agents and employees from directly or indirectly making or causing to be used, any radio sets made in accordance with or embodying the inventions of said original Letters Patent 2,162,282, or from infringing upon or violating the said Letters Patent in any way whatsoever. [45]

(2) For the costs and an accounting of profits and damages.

(3) For such other and further relief as the Court may deem meet and just.

JOHN FLAM,

914 Fidelity Building, Los  
Angeles 13, California.

J. B. DUDLEY,

1501 Apco Tower, Oklahoma  
City 2, Oklahoma.  
Attorneys for Plaintiff.

DUDLEY, DUVALL &  
DUDLEY,  
Of Counsel.

[Endorsed]: Filed March 7, 1945. Theodore M. Filson, Clerk. By D. Lucille Leslie, Deputy.

## CERTIFIED COPY

United States of America,  
Western District of Oklahoma—ss.

I, Theodore M. Filson, Clerk of the United States District Court in and for the Western District of Oklahoma, do hereby certify that the annexed and foregoing is a true and full copy of the original Bill of Complaint for Infringement of Letters Patent, filed March 7, 1945, in Case No. 2155-Civil, LeRoy J. Leishman, Plaintiff, vs. The Richards and Conover Company, a corporation, Defendant, as the same appears on file or of record in my office \* \* \*

In Testimony Whereof, I have hereunto subscribed my name and affixed the seal of the aforesaid Court at Oklahoma City this 15th day of December, A.D. 1945.

[Seal]                      THEODORE M. FILSON,  
Clerk.

By    D. LUCILLE LESLIE,  
Deputy Clerk. [47]

EXHIBIT E

In the United States District Court for the  
Western District of Oklahoma

No. 2155-Civil

LEROY J. LEISHMAN,

Plaintiff,

vs.

THE RICHARDS AND CONOVER COMPANY,  
a Corporation,

Defendant.

RESPONSE OF PLAINTIFF TO MOTION  
FOR BILL OF PARTICULARS OF THE  
DEFENDANT

(1) As to Paragraphs 1 and 2 of the motion for Bill of Particulars the plaintiff is willing to comply therewith, and in this connection states that the first nine listed models (25F, 26C, 26C-7, 27D, 28-O, 30-P, 29-B, 29B-6, and 35N) infringe Claims 7 to 11, inclusive, of the reissue patent, and the remaining five models (9-24, 9-24A, 16C, 18-O and 19-B) infringe Claims 7 and 11 of Patent No. 2,162,282.

(2) As to Paragraphs 3 and 4 of said motion the plaintiff resists the same for the reason that the information therein sought is premature and the defendant is not entitled to such relief until it has filed a responsive pleading herein, and in support of this contention plaintiff cites:

1. Smith vs. Buckeye Incubator Co. (U. S. Dist. Ct., S.D. Ohio, May 6, 1940), 3 Fed. Rules 148;

2. Bechik vs. Handy Mattress Accessories Corp. (U.S. Dist. Ct., E.D.N.Y., Jan. 8, 1942), 6 Fed. Rules 154;

3. National Nut Co. of California vs. Kellying Nut Co. (U.S. Dist. Ct., N.D. Ill., Nov. 28, 1944), 8 Fed. Rules 12e 241;

4. Bellavance vs. Frank Morrow Co., Inc., (U.S. Dist. Ct., D.R.I., Aug. 28, 1941), 5 Fed. Rules Service 150. [48]

(3) If the Court grants Paragraphs 3 and 4 of said motion, it should do so only on the condition that the defendant supply the plaintiff with a list of the patents, publications, prior inventions and prior uses on which it intends to rely, and in this connection states that this information should be furnished by the defendant simultaneously with the furnishing of the information by the plaintiff as contained in said paragraphs.

JOHN FLAM,

914 Fidelity Building, Los  
Angeles 13, California.

J. B. DUDLEY,

1501 Apco Tower, Oklahoma  
City 2, Oklahoma.  
Attorneys for Plaintiff.

DUDLEY, DUVALL &  
DUDLEY,  
Of Counsel.

[Endorsed]: Filed Sept. 13, 1945. Theodore M. Filson, Clerk. By Kenneth Groshong, Deputy. [49]

CERTIFIED COPY

United States of America,  
Western District of Oklahoma—ss.

I, Theodore M. Filson, Clerk of the United States District Court in and for the Western District of Oklahoma, do hereby certify that the annexed and foregoing is a true and full copy of the original Response of Plaintiff to Motion for Bill of Particulars of the Defendant, filed September 13, 1945, in Case No. 2155-Civil, Leroy J. Leishman, Plaintiff, vs. The Richards and Conover Company, a corporation, Defendant, as the same appears on file and of record in my office \* \* \*

In Testimony Whereof, I have hereunto subscribed my name and affixed the seal of the aforesaid Court at Oklahoma City this 15th day of December, A.D. 1945.

THEODORE M. FILSON,

Clerk.

By D. LUCILLE LESLIE,  
Deputy Clerk. [50]



## EXHIBIT G

Department of Commerce  
United States Patent Office

To all persons to whom these presents shall come,  
Greeting:

This is to Certify that the annexed is a true copy from the records of this office of the Disclaimer, filed January 16, 1939, in the matter of the Reissue Letters Patent of LeRoy J. Leishman, Number 20,827, granted August 16, 1938, for Improvements in Means and Methods for Turning Rotatable Objects to Predetermined Positions.

In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington, this ninth day of January, in the year of our Lord one thousand nine hundred and forty-six and of the Independence of the United States of America the one hundred and seventieth.

[Seal]

CASPER W. OOMS,  
Commissioner of Patents.

Attest:

D. E. WILSON,  
Chief of Division. [86]

DISCLAIMER

To the Commissioner of Patents:

Your petitioner, LeRoy J. Leishman, a citizen of the United States, residing at Los Angeles, in the county of Los Angeles and State of California, represents that in the matter of certain improvements in Means and Method for Turning Rotatable Objects to Predetermined Positions, for which letters patent of the United States No. Re. 20,827 were granted to him on the 16th day of August, 1938, he is the sole owner of said letters patent, and that he has reason to believe that through inadvertence and without fraudulent or deceptive intention claim 5 of said letters patent may be too broad, including that which may not have involved invention over the prior art.

Your petitioner, therefore, hereby enters this disclaimer to claim 5 of said letters patent.

Signed at Los Angeles, in the county of Los Angeles, and State of California, this 12th day of January, 1939.

LEROY J. LEISHMAN.

Witness:

J. H. LEISHMAN, SR.,

[Stamped]: Jan 16, 39, 138133 D M D 20.00  
Mail Division U. S. Patent Office Jan. 16, 1939  
Recorded U. S. Patent Office Issue Division Jan 16  
1939

[Endorsed]: Filed Jan. 23, 1946. [87]

[Title of District Court and Cause.]

AFFIDAVIT OF LEROY J. LEISHMAN FILED  
IN BEHALF OF DEFENDANT

State of California,  
County of Los Angeles—ss.

LeRoy J. Leishman, being first duly sworn, deposes and says:

That he is the defendant in the above-entitled action.

That he has prepared the collection of photographs and other illustrations identified as Defendant's Exhibits 1a, 1b, 2a, 2b, 3a, 3b, 4a, 4b, 5a, 5b, 6, 7, 8, 9a, 9b, 10a, 10b, 11a, 11b, 12a, 12b, 13a, 13b, 14a, 14b, 15a, 15b, 16a and 16b.

That the things represented in the said photographs [92] and illustrations, or others that were the same in all pertinent respects, were in existence before February 15, 1938.

That none of the said exhibits and none of the ten patents presented in support of Defendant's Memorandum Opposing Plaintiffs' Motion for Summary Judgment, were presented in evidence in the case of Leishman vs. Associated Wholesale Electric Company, mentioned in the said memorandum.

LEROY J. LEISHMAN,

Affiant.

Subscribed and sworn to before me this 15th day of February, 1946.

[Seal] BEATRICE BERGER,  
Notary Public in and for the County of Los Angeles,  
State of California.

My commission expires March 25, 1946.

[Endorsed]: Filed Feb. 15, 1946. [93]

[Title of District Court and Cause.]

MOTION TO DENY PLAINTIFFS' MOTION  
FOR SUMMARY JUDGMENT AND MO-  
TION TO DISMISS THE DECLARATORY  
JUDGMENT COMPLAINT

Now comes the defendant and moves that plaintiffs' motion for summary judgment be denied and also moves that the declaratory judgment complaint be dismissed.

I.

The motion to deny Plaintiffs' Motion for Summary Judgment is based upon the following grounds: [189]

1. Since the hearing on Plaintiffs' Motion for Summary Judgment, the situation has materially changed because of the holding of the United States District Court for the Western District of Oklahoma to the effect that the reissue patent here in suit is valid, that plungers and levers are equivalents, and that condenser Model 28 (Pl. Ex. 2) made by the Radio Condenser Company and condenser Model 31 (Pl. Ex. 4) manufactured by General Instrument Corporation are infringements of claims 7 to 11 of the said reissue patent. These are the very tuners which the present plaintiff has asked this court to hold are not infringements of the said claims.

2. Dr. Spotts, associate professor of mechanical engineering at Northwestern University, and expert witness for the defendant in the trial in Oklahoma, admitted in answer to questions of defendant's own

counsel that there would be no problem in substituting a plunger for a lever in the combination set forth in claims 7 to 11 of the reissue patent here in suit.

3. The authorities are in agreement that a summary judgment of non-infringement can only be rendered when there is clearly no infringement and when the facts that must support such a judgment are beyond dispute. In view of the decision of the U. S. District Court for the Western District of Oklahoma, based upon a full trial, to the effect that the tuners before your Honor are infringements of reissue patent No. Re. 20,827, it cannot summarily be held that there is clearly no infringement; and in the light of the expert testimony offered by both parties on the equivalency of levers and plungers in the Oklahoma suit, the proposition that they are not equivalents cannot be considered an indisputable fact. The requirements for a summary judgment in behalf of the plaintiff are manifestly not present. [190]

## II.

The Motion to Dismiss the Declaratory Judgment Complaint is based upon the following grounds:

1. Inasmuch as the Declaratory Judgment complaint was based upon the fact that the present defendant had filed a suit in Oklahoma against an alleged customer of a customer of the plaintiffs herein, and upon the allegation that the said plaintiffs were in need of relief that would enjoin the present defendant from prosecuting the said suit in



Oklahoma, and inasmuch as the trial of said suit is now in the past, there is no longer any legal basis for said complaint and the present defendant cannot be enjoined from going to trial on a case that has already been tried.

2. The declaratory judgment action will now serve no useful purpose. If the decision of the U. S. District Court for the Western District of Oklahoma is affirmed by the Tenth Circuit Court of Appeals, there will be a direct conflict between the decision of that court of appeals and the decision of the Ninth Circuit Court of Appeals in the case of *Leishman vs. Associated Wholesale Electric Co.*, 137 F. (2d) 722. The requirements will then be met for a writ of certiorari from the Supreme Court. Inasmuch as its decision will be binding upon the court here, no trial need be held. After a decision by the Supreme Court, the whole matter can then be disposed of here through defendant's counter-claim by means of a motion for summary judgment filed at that time by defendant if the claims are held valid and infringed, or by the plaintiffs if the claims are held invalid or not infringed. Should the Tenth Circuit Court of Appeals reverse the District Court for the Western [191] District of Oklahoma, the instant case can still be more properly disposed of through defendant's counter-claim.

LEROY J. LEISHMAN,  
Defendant.

Dated, Los Angeles, California, May 25, 1946.



## NOTICE OF HEARING

To Lyon & Lyon,

Attorneys for Plaintiffs:

Please take notice that the undersigned will bring the foregoing motions on for hearing before this Court in the court room of said Court, on the 10th day of June, 1946, at ten o'clock in the forenoon of that day, or as soon thereafter as the defendant and counsel for the plaintiff can be heard.

LEROY J. LEISHMAN,

Defendant.

Dated, Los Angeles, California, May 25, 1946.

(Affidavit of service by mail.)

[Endorsed]: Filed May 25, 1946. [192]

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[Title of District Court and Cause.]

## AFFIDAVIT OF LeROY J. LEISHMAN

LeRoy J. Leishman, the defendant in the above-entitled action, being duly sworn, deposes and says:

That he attended the trial of civil suit No. 2155, filed by him in the United States District Court for the Western District of Oklahoma, against The Richards and Conover Company, alleging infringement of claims 7 to 11, inclusive, of his U. S. patent No. Re. 20,827, through the sale of Motorola radio receiving sets of which models 25F, 26C, 26C-7, 27D, 28-O, 30-P, 29-B and 29B-6 are typical examples; that the said trial was held before the said court beginning on April 29, 1946; [193]

That Dr. Spotts, associate professor of mechanical engineering at Northwestern University, testified at the said trial as an expert witness for the defendant, The Richards and Conover Company, and that in answer to a question of counsel for the said The Richards and Conover Company, Dr. Spotts stated that no problem would be involved in substituting a plunger for a lever in the tuner shown and described in the said patent;

That at the conclusion of the trial the court rendered its opinion in favor of the plaintiff, LeRoy J. Leishman, on all issues with respect to patent No. Re. 20,827, and holding that the plungers in the tuners in the accused sets are the equivalents of the levers of the said patent.

/s/ LeROY J. LEISHMAN.

Subscribed and sworn to before me this 25th day of May, 1946.

[Seal] BEATRICE BURGER,  
Notary Public in and for the County of Los Angeles, State of California.

My Commission Expires March 25, 1950.

(Affidavit of Service by Mail.)

[Endorsed]: Filed May 25, 1946. [194]

In the United States District Court for the  
Western District of Oklahoma

Civil Action No. 2155

LeROY J. LEISHMAN,

Plaintiff,

vs.

THE RICHARDS AND CONOVER COMPANY,  
a Corporation,

Defendant.

### FINDINGS OF FACT AND CONCLUSIONS OF LAW

This Cause coming on for trial upon the merits, and evidence having been introduced and the cause having been submitted to the Court, and the Court having rendered its decision herein, Now Therefore, the Court makes the following Findings of Fact and Conclusions of Law:

#### Findings of Fact

1. The plaintiff, LeRoy J. Leishman, is a citizen of the State of California, and resides in the City of Los Angeles, California.

2. The defendant, The Richards and Conover Company, is a corporation organized under, and existing by virtue of, the laws of the State of Missouri, and has a regular and established place of business in the City of Oklahoma City, State of Oklahoma.

3. Galvin Manufacturing Corporation, a corporation organized under, and existing by virtue of, the laws of the State of Illinois, and having its principal place of business [195] in the City of Chicago, State of Illinois, is the manufacturer of the accused devices, and assumed the defense of this action against the defendant, who was a distributor of its products, and therefore said Galvin Manufacturing Corporation is bound by the judgment herein.

4. On February 15, 1938, original United States Letters Patent No. 2,108,538 were duly and legally issued to plaintiff for an invention in "Means and Method for Turning Rotatable Objects to Predetermined Positions," and on August 16, 1938, said Letters Patent were surrendered, and were duly and legally reissued as reissue Letters Patent No. 20,827; and on or about January 16, 1939, the plaintiff disclaimed claim 5 of said reissue Letters Patent No. 20,827.

5. Plaintiff, since the date of the issuance of said original Letters Patent and until said original Letters Patent were surrendered, has been the owner of said original Letters Patent, and plaintiff, since the date when said reissue Letters Patent were granted, has been and still is the owner of said reissue Letters Patent.

6. Claims 7, 8, 9, 10 and 11 of the reissue patent No. 20,827 are clearly valid, and clearly infringed due to the use of tuning devices in the fol-

lowing radio receiver sets manufactured by said Galvin Manufacturing Corporation and sold by defendant: Models 25F, 26C, 26C-7, 27D, 28-O, 30-P, 29-B, and 29B-6. This finding is made without any regard to any commercial success which plaintiff's tuners have attained.

7. The reissue patent No. 20,827, and especially claims 7, 8, 9, 10 and 11 thereof, are for the same invention as patent 2,108,538; and it appears, from the face of the said patent 2,108,538, that plaintiff intended to claim the invention now claimed by claims 7, 8, 9, 10 and 11 in the reissue patent No. 20,827. [196]

8. The reissue patent No. 20,827 conforms in all respects with the requirements of Section 4916 of the Revised Statutes.

9. The disclaimers filed by plaintiff with respect to reissue patent No. 20,827 are in conformity with Section 4917 of the Revised Statutes.

10. The combination of Plaintiff's claims 7, 8, 9, 10 and 11 of his reissue patent No. 20,827 is illustrated in said patent as a structure including a rocker or positionable element connected with a tuning element, such as a variable condenser, and an adjustable tappet or positioning element mounted on a manual means for moving it, such as a lever, whereby the tappet is brought against the rocker to a position determined by the adjusted position of the tappet. There is a recess in the rocker and, when the rocker and tappet are completely engaged,



the axis of the tappet becomes substantially coaxial with the axis of the rocker.

11. The tappet or positioning element described in plaintiff's reissue patent No. 20,827 may be mounted either on a lever or a plunger to move the tappet, since a lever and a plunger perform their functions in the same way and are mechanical equivalents.

12. The finding 11 is based not only upon the evidence offered on behalf of plaintiff, but also upon the direct testimony of defendant's expert, Dr. Spotts, who testified to the effect that the substitution of plungers for levers is a simple one in the combination covered by claims 7, 8, 9, 10 and 11 of the said reissue patent.

13. The coaxial relationship between the axis of the tappet, or adjustable means, and the axis of the rocker is for the purpose of preventing any rotation whatever of the adjusted [197] tappet and rocker during the adjusting process. Coaxiality has been used in the past for the opposite purpose of permitting parts to move freely and without binding.

14. The defendant presented no example of the use of a coaxial relationship that was at all analogous to the use made of this relationship in the combination set forth in the claims of the reissue patent in suit; and defendant's expert, Dr. Spotts, stated on cross-examination that he knew of no instance in which a coaxial relationship had been previously used for a similar purpose.



15. The coaxial relationship of the tappet and rocker requires that one or both of these members be especially shaped with respect to the other; and a coaxial relationship is not attained merely by mounting a tappet upon a plunger and passing the plunger through an opening in the rocker.

16. The use of plungers for operating mechanical automatic tuners was known long prior to plaintiff's development of his patented structure set forth in the reissue patent in suit.

17. It would not avoid infringement of claims 7, 8, 9, 10 and 11 of the reissue patent in suit to form a rocker or a tappet such as to render it unnecessary to provide an opening in the rocker for bringing the tappet and rocker into substantially coaxial relation when they are fully engaged. Such variations are exemplified in plaintiff's exhibits 40 and 42.

18. There had been a demand in the radio industry for many years for a satisfactory automatic tuner; and numerous inventors in the United States and foreign countries sought to satisfy this demand by devices described in patent applications dating as far back as 1924. [198]

19. Schaefer, exhibit 20, Marschalk, exhibit 18, Lane & Mackey, exhibit 22, and Soffietti, exhibit 21, in Italy, all tried to produce acceptable tuners using an adjustable tappet, but their tuners were all either more or less complex or much harder to adjust than plaintiff's simple structure.

20. The structure of defendant's model, exhibit

M, is not a correct or true representation of the combined teachings of the Marschalk patent 2,072,897 and the Schaefer patent 1,906,106, but was made after hindsight had shown the advantages of providing such a structure. Such a structure could not be arrived at by an ordinary mechanic skilled in the art prior to plaintiff's invention covered by claims 7, 8, 9, 10 and 11 of the reissues patent in suit.

21. In the summer of 1937, the radio industry was using to a great extent automatic tuners referred to as motor driven tuners and telephone dial tuners. These were so inaccurate mechanically that they required expensive automatic frequency control circuits to make them at all acceptable to the trade. These tuners are shown in the June, July, and August, 1937, issues of Radio Retailing.

22. Plaintiffs, in the summer of 1937, interviewed numerous radio set manufacturers, including the Crosley Corporation and Clinton Manufacturing Company, as well as Crowe Name Plate and Manufacturing Company, which was a parts manufacturer. All of these manufacturers interviewed were dissatisfied with the then existing forms of automatic tuning devices, and expressed great interest in plaintiff's proposals to provide a new form of automatic tuning. Plaintiff told these manufacturers of his issued patent 2,084,851, issued June 22, 1937, and demonstrated to them another form of tuner using two point positioning and utilizing the invention disclosed in a patent application [199] which later issued as patent 2,163,343, and the per-

tinent features of which are embodied in plaintiff's exhibit 38. During the demonstrations at some of these manufacturers' plants, the relative merits of using plungers and levers as a means for operating radio tuners were discussed.

23. As a result of this trip in the summer of 1937, Crowe Name Plate and Manufacturing Company and Clinton Manufacturing Company took licenses under the application that resulted in said patent No. 2,163,343; and, later, Crowe Name Plate and Manufacturing Company took a license under patent 2,108,538, said latter patent being later surrendered and reissued as the reissue patent in suit.

24. On June 22, 1937, the date of issue of patent 2,084,851, knowledge of the structure incorporated in the reissue patent in suit became available to the public and to radio set and parts manufacturers, since the file wrapper and history of said patent 2,084,851 included Figs. 14, 15, and 16 and their descriptions, said figures being identical with the drawings of the patent in suit. Said Figs. 14, 15, and 16 were cancelled, along with the descriptions thereof, in order to incorporate them in the divisional application that resulted in patent 2,108,538, which was reissued as the patent in suit, but these figures and their descriptions nevertheless remained in the file wrapper of patent No. 2,084,851.

25. Early in the year 1938, radio set manufacturers and radio parts manufacturers began to use radio tuners embodying the invention covered by claims 7, 8, 9, 10 and 11 of the reissue patent in

suit. Tuners of this kind were supplied to the public in approximately 8,000,000 radio sets up to April, 1942. These tuners were sufficiently accurate mechanically to operate satisfactorily without the need of automatic frequency control [200] circuits, and were easy to adjust to different broadcasting stations. The popularity of the motor driven and telephone dial tuners declined after 1938, and are now virtually obsolete.

26. The infringing tuners sold by defendant are exemplified generally by the defendant's exhibits G and H. These infringing devices were manufactured respectively by Radio Condenser Company and General Instrument Corporation, which are the joint plaintiffs in an action now pending in the District Court of the United States, Southern District of California, Central Division, and entitled: Radio Condenser Company and General Instrument Corporation v. LeRoy J. Leishman, No. 4395 B.H.

27. The tuners referred to in Finding 26 do not differ in any essential respect, so far as the question of infringement is concerned, from the tuner manufactured by Crosley Corporation of Cincinnati, Ohio, and which was the accused device in the action entitled LeRoy J. Leishman v. Associated Wholesale Electric Co., tried in the Southern District of California and reported in 36 F. Supp. 804. In said action, the Circuit Court of Appeals for the Ninth Circuit rendered its opinion, reported in 137 F (2nd) 722.



## Conclusions of Law

1. Claims 7, 8, 9, 10 and 11 of the reissue patent No. 20,827 are good and valid in law.

2. Defendant infringed said claims 7, 8, 9, 10 and 11 of said reissue patent by the sale of Motorola sets, Models 25F, 26C, 26C-7, 27D, 28-O, 30-P, 29-B, and 29B-6, in the Western District of Oklahoma and elsewhere. These sets were manufactured by Galvin Manufacturing Corporation. [201]

The above findings and conclusions are limited to the issues on Reissue patent 20,827; further findings and conclusions will be made hereafter on the issues with respect to the other patent in suit, No. 2-162,282.

STEPHEN S. CHANDLER, JR.,  
Judge.

Dated 6/10, 1946.

[Endorsed]: Filed June 10, 1946.

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[Title of District Court and Cause.]

INTERLOCUTORY JUDGMENT RE REISSUE  
PATENT 20,827

This cause came on to be heard at the term of this Court held in Oklahoma City, Oklahoma; and, therefore, upon consideration thereof, it is hereby ordered, adjudged, and decreed:

1. That plaintiff, LeRoy J. Leishman, is the owner of United States Letters Patent Reissue No.

20,827, the invention disclosed therein, and of all rights and privileges under the said United States Letters Patent.

2. That claims 7, 8, 9, 10 and 11 of said reissue patent are good and valid in law.

3. That defendant, The Richards and Conover Company, has infringed claims 7, 8, 9, 10 and 11 of said reissue patent by the sale of Motorola sets: Models 25F, 26C, 26C-7, 27D, 28-O, 30-P, 29-B, and 29B-6, which embodied tuners of the type exemplified in defendant's exhibits G and H.

4. That a perpetual injunction issue forthwith against the defendant, The Richards and Conover Company, its officers, agents, servants, and employees, restraining them from directly or indirectly making or causing to be made, selling or causing to be sold, or using or causing to be used, any tuners for radio sets made in accordance with or embodying the inventions set forth in claims 7, 8, 9, 10 and 11 of said reissue United States Letters Patent No. 20,827, and as exemplified in [203] defendant's exhibits G and H, or from infringing upon or violating the said claims in any way whatever.

5. That plaintiff recover from the defendant, The Richards and Conover Company, the damages which plaintiff has suffered and the profits which the said defendant has made by reason of its infringement of said Reissue Letters Patent No. 20,827, and that this cause be referred to  
to take and report on account of such profits and



damages, and that the defendant, its officers, agents, servants, and employees, are required to attend before said master from time to time as he shall direct, and to produce before him all such books, papers, vouchers, documents, and devices, and to submit to such oral examination as he may direct.

6. That the plaintiff recover from the defendant his costs and disbursements to be taxed by the clerk, and in the amount of \_\_\_\_\_ ; and that plaintiff have execution therefor against the said defendant.

STEPHEN S. CHANDLER, JR.,  
Judge.

Dated 6/10, 1946.

[Endorsed]: Filed June 10, 1946.

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CERTIFIED COPY

United States of America,  
Western District of Oklahoma—ss.

I, Theodore M. Filson, Clerk of the United States District Court in and for the Western District of Oklahoma, do hereby certify that the annexed and foregoing is a true and full copy of the original

1. Findings of Fact and Conclusions of Law, filed June 10, 1946, and

2. Interlocutory Judgment Re Reissue Patent 20,827, filed and entered June 10, 1946, in case No. 2155-Civil, LeRoy J. Leishman, Plaintiff, vs. The

Richards and Conover Company, Defendant, as the same appear on file and of record in my office.

In Testimony Whereof, I have hereunto subscribed my name and affixed the seal of the aforesaid Court at Oklahoma City this 10th day of June, A.D. 1946.

[Seal]                      THEODORE M. FILSON,  
Clerk.

By /s/ D. LUCILLE LESLIE,  
Deputy Clerk.

[Endorsed]: Filed May 29, 1947.

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In the United States District Court, Southern  
District of California, Central Division

No. 4395-B—Civil

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,  
Plaintiffs,

vs.

LeROY J. LEISHMAN,

Defendant.

### MOTION UNDER RULE 15d

Now Comes the defendant in the above-entitled cause, and moves that this court grant leave to the defendant to file a supplemental answer to the com-

plaint and a second supplemental counterclaim, copies of which are hereto annexed, in the above-entitled cause, and that the order for a summary judgment be vacated; and the defendant says:

1. On the 20th day of April, 1945, plaintiffs filed their complaint in this court against defendant, asking [206] this court to declare claims 7, 8, 9, 10 and 11 of patent No. Re. 20,827 invalid and not infringed by the plaintiffs as a result of their manufacture and sale of automatic tuning devices represented by Radio Condenser Company Model 28 condenser and General Instrument Corporation Model 31 tuner.

2. Thereafter, on the 16th day of November, 1945, defendant filed his answer in this cause, together with a counterclaim asking that this court hold the said claims of the said reissue patent to be valid and infringed by the plaintiffs as a result of their manufacture and sale of automatic tuning devices represented by the said models.

3. Since the filing of the said answer and counterclaim, the U. S. District Court for the Western District of Oklahoma, in the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action No. 2155, has held that claims 7, 8, 9, 10 and 11 of the said reissue patent are valid and that Radio Condenser model 28 condenser and General Instrument model 31 tuner are infringements of the said claims of the said reissue patent.

4. The Findings of Fact, Conclusions of Law, and Interlocutory Judgment in the said case in the

U. S. District Court for the Western District of Oklahoma were signed by the said court on June 10, 1946.

5. The record of the trial of the said case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action No. 2155, contains evidence that the plaintiffs [207] in the present action participated in the defense of the said The Richards and Conover Company.

/s/ LeROY J. LEISHMAN,  
Defendant.

Dated, Los Angeles, California, June 21, 1946.

#### NOTICE OF HEARING

You Will Please Take Notice that on the 1st day of July, 1946, at 10 a.m., or as soon thereafter as the defendant and counsel for the plaintiffs can be heard, the undersigned defendant will bring on for hearing in the courtroom of the above-entitled court, Los Angeles, California, defendant's Motion under Rule 15d.

/s/ LeROY J. LEISHMAN,  
Defendant.

Dated, Los Angeles, California, June 21, 1946.

(Affidavit of Service by Mail.)

[Endorsed]: Filed June 21, 1946. [208]

[Title of District Court and Cause.]

AFFIDAVIT OF MAXWELL JAMES

State of New York,  
County of New York—ss.

Maxwell James, being duly sworn, hereby deposes and says as follows:

(1) I am a member of the firm of James and Franklin, patent lawyers, located at 521 Fifth Avenue, New York 17, New York. I am and have been for many years the attorney in patent causes for both of the plaintiffs in this suit, namely Radio Condenser Company and General Instrument Corporation. I am fully acquainted with all of the facts and procedure in this suit, and have direct knowledge of the facts hereinbelow set forth. [209]

(2) At no time has either of the plaintiffs, Radio Condenser Company or General Instrument Corporation, controlled the defense or participated in any pecuniary or other manner in the control of the defense in the case of LeRoy J. Leishman vs. The Richards and Conover Company, pending in the United States District Court for the Western District of Oklahoma.

(3) In the Reporter's Transcript of Proceedings in the present case of the hearing had before your Honor on Tuesday, June 11, 1946, the charge is made (addressed to Leonard S. Lyon, Sr., Esq.) at pages 44 and 45, as follows:

"Isn't it true that you loaned to counsel in



that case a model that you prepared for the case here of the Marschalk tuner?" (By Mr. Leishman.)

"Mr. Leishman: You loaned them a model that was prepared showing how the Schaefer tuner could be combined with the Marschalk tuner, certain elements, did you not?"

It was deponent who did lend to Mr. Foorman L. Mueller, attorney for the defendant in the Oklahoma suit, the Richards and Conover Company, and for the Galvin Company who assumed the defense of the Oklahoma suit, a model of the tuner of the Marschalk patent No. 2,072,897, and a model showing how the tuner of the Schaefer patent No. 1,906,106 could be combined with the Marschalk tuner. The circumstances leading to such loan, are as follows:

(a) On April 2, 1946, Mr. Mueller called deponent on the telephone from Chicago, and informed the deponent that Judge Chandler was compelling Mr. Mueller to go to trial in the Oklahoma suit on Monday, April 29th, and that he, Mr. Mueller, was not fully prepared for trial; that he, Mr. Mueller, did not have any or many physical exhibits to explain to the Court at such trial; and Mr. Mueller inquired whether deponent was [210] in possession of any physical exhibits that deponent might lend to Mr. Mueller.

(b) Deponent replied that several years ago, the model maker for Radio Condenser Com-



pany had prepared a model of the Marschalk patent and another model showing how the lever device of the Schaefer patent could be substituted for the lever device of the Marschalk patent, to demonstrate that there was no invention in so doing, and that deponent was and had been in possession of these two models for these many years, and that deponent would be glad to lend these models to Mr. Mueller for whatever use they might serve him, to be returned to deponent as soon as possible.

(c) Pursuant to this discussion, these two models were delivered and loaned to Mr. Mueller.

(4) The lending of these two models to Mr. Mueller under the circumstances mentioned, ended the assistance thus alleged by Mr. Leishman to have been given to Mr. Mueller. Deponent (for himself and on or in behalf of either of the plaintiffs herein) had absolutely no voice even as to the manner in which these models were to be used at the Oklahoma trial, and deponent (again for himself and on or in behalf of either of the plaintiffs herein) had no voice whatsoever in directing, determining or in any wise controlling any phase whatsoever of the trial in the Oklahoma case.

/s/ MAXWELL JAMES,  
Affiant.

Subscribed and sworn to before me this 24th day of June, 1946.

[Seal]     /s/ MARIE STIRISS,  
Notary Public, New York County. N. Y. Co. Clk's  
No. 539 Reg. No. 1175-S-7.

Commission expires March 30, 1947.

[Affidavit of service by mail.]

[Endorsed]: Filed June 28, 1946. [211]

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[Title of District Court and Cause.]

SECOND AFFIDAVIT IN SUPPORT OF  
MOTION UNDER RULE 15(d)

State of California,  
County of Los Angeles—ss.

LeRoy J. Leishman, being duly sworn, deposes and says:

1. That he is the defendant in the above entitled action and the plaintiff in Civil Action No. 2155, brought in the United States District Court for the Western District of Oklahoma; and that he attended the trial of Civil Action No. 2155, beginning on the 29th day of April, 1946, in Oklahoma City, Oklahoma. [212]

2. That all the models presented in behalf of the defendant in said Civil Action No. 2155, in opposition to Reissue patent No. Re. 20,827, were stock production models, excepting two; that these two were specially constructed models designed for

presenting defense arguments to the court, and were furnished by the plaintiffs in the present action.

3. That one of the said specially constructed models was designed and constructed to illustrate to a trial court the device shown and described in patent No. 2,072,897, issued to Marschalk, and cited both by the defendants herein and by the defendants in the said action against The Richards and Conover Company.

4. That the other of the said specially constructed models was known at the said trial as Defendant's Exhibit M; that the said model consisted of a lever and tappet assembly especially constructed to conform in general to that shown in the Schaefer patent No. 1,906,106, cited both by the plaintiff in the instant action and by the defendant in the Oklahoma action, and of a rocker especially constructed to conform in some respects to that shown in the said Marschalk patent; and that the simulated Marschalk rocker was changed in various material respects from the construction shown in the Marschalk patent.

5. That Mr. Foorman L. Mueller, counsel for the defendant in the said Civil Action No. 2155, stated that the said model Exhibit M, was furnished by the plaintiffs in the instant action.

6. That the said model Exhibit M was obviously built for the express purpose of presenting and illustrating the defense that the structure set forth

in claims 7 to 11 of reissue patent No. Re. 20,827 could be arrived at without invention by combining the teachings of the said Schaefer and Marschalk patents; and that this legal defense necessarily had to be formulated [213] before the said Model Exhibit M could have been built.

7. That early in the trial of the said Oklahoma action, Mr. Mueller, counsel for the defendant there, stated that Dr. Spotts, who was then in Chicago, could be present at the trial only on Wednesday, May first, and that he, Mueller, therefore wanted permission to put Dr. Spotts on the witness stand on that day irrespective of whether or not the plaintiff had finished presenting his case; and that in order to secure such consent, Mr. Mueller exhibited the said model Exhibit M and stated that Dr. Spotts' testimony would consist solely of an explanation of the Marschalk and Schaefer devices and of the model last above mentioned.

8. That the said model Exhibit M was of such a nature that it was, and would be, perfectly obvious to anyone familiar with the Marschalk and Schaefer patents, how the said model was intended to be used at the trial—so much so, in fact, that Mr. John Flam and affiant were able, merely as a result of seeing the said model, to prepare Dr. Spotts' cross-examination before he had even left Chicago.

9. That Dr. Spotts was the only witness against reissue patent No. Re. 20,827, at the trial of the said Oklahoma action, and that his testimony

against the said reissue patent dealt solely with said model Exhibit M and with such advance explanations of the Schaefer and Marschalk structures as were necessary to give meaning and significance to the said model.

10. That a certified copy of the Findings of Fact, Conclusions of Law, and Judgment in the Oklahoma action are on file before this court.

/s/ LEROY J. LEISHMAN,  
Affiant.

Subscribed and sworn to before me this 6th day of July, 1946.

[Seal] /s/ BEATRICE BURGER,  
Notary Public in and for the County of Los Angeles, State of California.

My commission expires March 25, 1950.

[Endorsed]: Filed July 8, 1946. [214]

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[Title of District Court and Cause.]

DEFENDANT'S FIRST SUPPLEMENTAL  
ANSWER AND SECOND SUPPLEMENTAL  
COUNTERCLAIM

To the Honorable the Judges of the District Court  
of the United States in and for the Southern  
District of California:

Defendant, as a supplemental answer to Plaintiff's Complaint in the above entitled cause, says:



## I.

Defendant alleges that the plaintiffs herein had the right to participate in and control the defense of the action [215] entitled "LeRoy J. Leishman v. The Richards and Conover Company," specified in paragraph 4 of plaintiffs' complaint herein, said action being in the United States District Court for the Western District of Oklahoma, Civil Action No. 2155.

## II.

Defendant alleges that the plaintiffs herein did participate in, and did jointly control, the defense of said action against The Richards and Conover Company.

## III.

Defendant alleges that the plaintiffs designed and constructed a special model to illustrate to a trial court the device shown and described in patent No. 2,072,897, issued to Marschalk, and cited both by the plaintiffs herein and by the defendants in the said action against The Richards and Conover Company.

## IV.

Defendant alleges that the plaintiffs herein furnished the said specially constructed model of the Marschalk device to the defendant in the said action against The Richards and Conover Company to be used in the defense of said action to explain the workings of said Marschalk device to the court.



## V.

Defendant alleges that the plaintiffs herein prepared a defense to be used to attack the validity of defendant's patent No. Re. 20,827, which said defense was to the effect that the structure of said patent could be arrived at by combining the teachings of the said Marschalk patent and the teachings of patent No. 1,906,106, issued to Schaefer, which said Schaefer patent was cited by the [216] plaintiffs herein as well as by the defendant in the said action against the said The Richards and Conover Company; that the plaintiffs herein, at their expense, designed a model for the purpose of presenting such defense to a trial court; that the plaintiffs herein, at their expense, constructed a model according to said design; that the said model consisted of a lever and tappet assembly especially constructed by the plaintiffs to conform in general to that shown and described in the said Schaefer patent, and of a rocker especially constructed by the plaintiffs to conform in some respects to that shown in the said Marschalk patent; that the said model was ingeniously conceived and built in an attempt to give the court the erroneous impression that the structure of patent No. Re. 20,827 would be arrived at without invention by combining the teachings of the said Schaefer and Marschalk patents; that the simulated Marschalk rocker was changed in various material respects from the construction shown in the Marschalk patent in order that the model might respond to the language of the claims at issue in

the present action as well as in the action against the said The Richards and Conover Company.

## VI.

The defendant alleges that Mr. Mueller, counsel for the said The Richards and Conover Company, conferred on various occasions with Maxwell James, who is and has been for many years the attorney in patent causes for both of the plaintiffs in the present suit; that in one of such conferences, held by telephone, Mr. Mueller asked Mr. James for help in the preparation of the defense of the said action against the said The Richards and Conover Company. [217]

## VII.

Defendant alleges that Mr. James, instead of refusing to take any part in the defense of said suit against the said The Richards and Conover Company, or to exercise any control over it, responded to Mr. Mueller's request and furnished him not only with the defense that the said reissue patent was invalid as merely combining the teachings of the said Marschalk and Schaefer patents, but also with the means to illustrate and explain this defense to the court; that the said means consisted of the two specially constructed models hereinbefore mentioned.

## VIII.

Defendant alleges that the defendant in the said suit against the said The Richards and Conover Company presented only one witness against re-

issue patent No. 20,827, said witness being Dr. Spotts; and that Dr. Spotts' testimony against the said reissue patent consisted solely of an explanation of the Schaefer and Marschalk structures and of the model furnished by the plaintiffs herein for the purpose of making it appear that the device shown and described in the said reissue patent could be arrived at without invention by combining the Marschalk and Schaefer teachings.

### IX.

Defendant alleges that no defense was presented at the trial of the said action against The Richards and Conover Company excepting the defense which the models furnished by the plaintiffs herein were especially built to demonstrate; and that no other model of any kind was presented by the defendant at the said trial excepting regular stock production models. [218]

### X.

Defendant alleges that the furnishing of these specially constructed models controlled the defense against reissue patent No. Re. 20,827 in the said action against The Richards and Conover Company; that the said models were used at the trial for the purpose for which they were designed and intended to be used, namely, to present the defense that reissue patent No. 20,827 was invalid as involving no invention over the combined teachings of Schaefer and Marschalk.

## XI.

Defendant alleges that the plaintiffs herein participated in the defense and in the control of the defense of said action against The Richards and Conover Company in yet other ways than those here specifically set forth, which said other ways are yet to be discovered and may not be discovered until witnesses can be examined at a trial of the present action.

## XII.

Defendant alleges that in the said action against The Richards and Conover Company in the United States District Court for the Western District of Oklahoma, Civil Action No. 2155, an interlocutory judgment as well as findings of fact and conclusions of law were duly filed on the tenth day of June, 1946; that said judgment, findings and conclusions constituted a final determination that claims 7, 8, 9, 10 and 11 of reissue patent No. Re. 20,827, here in suit, were valid and were infringed by tuners manufactured by the plaintiffs in this action—i.e., Radio Condenser Company and General Instrument Corporation; that Findings [219] 6, 20, and 26 of said suit in the Western District of Oklahoma read as follows:

“6. Claims 7, 8, 9, 10 and 11 of the reissue patent No. 20,827 are clearly valid, and clearly infringed due to the use of tuning devices in the following radio receiver sets manufactured by said Galvin Manufacturing Corporation and sold by defendant; Models 25F; 26C; 26C-7;



27D; 28-O; 20-P; 29-B and 29 B-6. This finding is made without any regard to any commercial success which plaintiff's tuners have attained."

"20. The structure of defendant's model, exhibit M, is not a correct or true representation of the combined teachings of the Marschalk patent 2,072,897 and the Schaefer patent 1,906,106, but was made after hindsight had shown the advantages of providing such a structure. Such a structure could not be arrived at by an ordinary mechanic skilled in the art prior to plaintiff's invention covered by claims 7, 8, 9, 10 and 11 of the reissue patent in suit."

"26. The infringing tuners sold by defendant are exemplified generally by the defendant's exhibits G and H. These infringing devices were manufactured respectively by Radio Condenser Company and General Instrument Corporation, which are the joint plaintiffs in an action now pending in the District Court of the United States, Southern District of California, Central Division, and entitled: Radio Condenser Company and General Instrument Corporation v. LeRoy J. Leishman, No. 4395 B. H."

Exhibit M, referred to in Finding 20, *supra*, was one of the two specially constructed models furnished to counsel for the defendant in the Oklahoma action by the plaintiffs [220] in the present action.



## XIII.

Defendant alleges that by participating in the defense and control of said action in the Western District of Oklahoma, the plaintiffs herein are bound by the outcome of that suit; and accordingly they are not entitled to any declaratory relief or any relief whatever, since the devices held to be infringements of said claims 7, 8, 9, 10 and 11 of reissue patent No. Re. 20,827 in said action in the Western District of Oklahoma are identical with those specified in paragraphs 4 and 5 of plaintiffs' complaint herein, and were of plaintiffs' manufacture.

## Defendant's Second Supplemental Counterclaim

In further complaint of the plaintiffs:

## I.

Defendant alleges that the plaintiffs herein had the right to participate in and control the defense of the action entitled "LeRoy J. Leishman v. The Richards and Conover Company," specified in paragraph 4 of plaintiffs' complaint herein, said action being in the United States District Court for the Western District of Oklahoma, Civil Action No. 2155.

## II.

Defendant alleges that the plaintiffs herein did participate in, and did jointly control, the defense of said action against The Richards and Conover Company. [221]

## III.

Defendant alleges that the plaintiffs designed and constructed a special model to illustrate to a trial court the device shown and described in patent No. 2,072,897, issued to Marschalk, and cited both by the plaintiffs herein and by the defendants in the said action against The Richards and Conover Company.

## IV.

Defendant alleges that the plaintiffs herein furnished the said specially constructed model of the Marschalk device to the defendant in the said action against The Richards and Conover Company to be used in the defense of said action to explain the workings of said Marschalk device to the court.

## V.

Defendant alleges that the plaintiffs herein prepared a defense to be used to attack the validity of defendant's patent No. Re. 20,827, which said defense was to the effect that the structure of said patent could be arrived at by combining the teachings of the said Marschalk patent and the teachings of patent No. 1,906,106, issued to Schaefer, which said Schaefer patent was cited by the plaintiffs herein as well as by the defendant in the said action against the said The Richards and Conover Company; that the plaintiffs herein, at their expense, designed a model for the purpose of presenting such defense to a trial court; that the plaintiffs herein, at their ex-

pense, constructed a model according to said design; that the said model consisted of a lever and tappet assembly especially constructed by the plaintiffs to conform in general to that shown and described in the said Schaefer patent, and of a [222] rocker especially constructed by the plaintiffs to conform in some respects to that shown in the said Marschalk patent; that the said model was ingeniously conceived and built in an attempt to give the court the erroneous impression that the structure of patent No. Re. 20,827 would be arrived at without invention by combining the teachings of the said Schaefer and Marschalk patents; that the simulated Marschalk rocker was changed in various material respects from the construction shown in the Marschalk patent in order that the model might respond to the language of the claims at issue in the present action as well as in the action against the said The Richards and Conover Company.

## VI.

The defendant alleges that Mr. Mueller, counsel for the said The Richards and Conover Company, conferred on various occasions with Maxwell James, who is and has been for many years the attorney in patent causes for both of the plaintiffs in the present suit; that in one of such conferences, held by telephone, Mr. Mueller asked Mr. James for help in the preparation of the defense of the said action against the said The Richards and Conover Company.

## VII.

Defendant alleges that Mr. James, instead of refusing to take any part in the defense of said suit against the said The Richards and Conover Company, or to exercise any control over it, responded to Mr. Mueller's request and furnished him not only with the defense that the said reissue patent was invalid as merely combining the teachings of the said Marschalk and Schaefer patents, but also with the means to illustrate and explain this defense to the court; that the [223] said means consisted of the two specially constructed models hereinbefore mentioned.

## VIII.

Defendant alleges that the defendant in the said suit against the said The Richards and Conover Company presented only one witness against reissue patent No. 20,827, said witness being Dr. Spotts; and that Dr. Spotts' testimony against the said reissue patent consisted solely of an explanation of the Schaefer and Marschalk structures and of the model furnished by the plaintiffs herein for the purpose of making it appear that the device shown and described in the said reissue patent could be arrived at without invention by combining the Marschalk and Schaefer teachings.

## IX.

Defendant alleges that no defense was presented at the trial of the said action against The Richards and Conover Company excepting the defense which

the models furnished by the plaintiffs herein were especially built to demonstrate; and that no other model of any kind was presented by the defendant at the said trial excepting regular stock production models.

### X.

Defendant alleges that the furnishing of these specially constructed models controlled the defense against reissue patent No. Re. 20,827 in the said action against The Richards and Conover Company; that the said models were used at the trial for the purpose for which they were designed and intended to be used, namely, to present the defense that re-issue patent No. 20,827 was invalid as involving no invention over the combined teachings of Schaefer and Marschalk. [224]

### XI.

Defendant alleges that the plaintiffs herein participated in the defense and in the control of the defense of said action against The Richards and Conover Company in yet other ways than those here specifically set forth, which said other ways are yet to be discovered and may not be discovered until witnesses can be examined at a trial of the present action.

### XII.

Defendant alleges that in the said action against The Richards and Conover Company in the United States District Court for the Western District of Oklahoma, Civil Action No. 2155, an interlocutory



judgment as well as findings of fact and conclusions of law were duly filed on the tenth day of June, 1946; that said judgment, findings and conclusions constituted a final determination that claims 7, 8, 9, 10 and 11 of reissue patent No. Re. 20,827, here in suit, were valid and were infringed by tuners manufactured by the plaintiffs in this action—i.e., Radio Condenser Company and General Instrument Corporation; that Findings 6, 20 and 26 of said suit in the Western District of Oklahoma read as follows:

“6. Claims 7, 8, 9, 10 and 11 of the reissue patent No. 20,827 are clearly valid, and clearly infringed due to the use of tuning devices in the following radio receiver sets manufactured by said Galvin Manufacturing Corporation and sold by defendant: Models 25F, 26C, 26C-7, 27D, 28-O, 20-P, 29-B, and 29B-6. This finding is made without any regard to any commercial success which plaintiff’s tuners have attained.” [225]

“20. The structure of defendant’s model, Exhibit M, is not a correct or true representation of the combined teachings of the Marshalk patent 2,072,897 and the Schaefer patent 1,906,106, but was made after hindsight had shown the advantages of providing such a structure. Such a structure could not be arrived at by an ordinary mechanic skilled in the art prior to plaintiff’s invention covered by claims 7, 8, 9, 10 and 11 of the reissue patent in suit.”

“26. The infringing tuners sold by defendant are exemplified generally by the defendant’s exhibits G and H. These infringing devices were manufactured respectively by Radio Condenser Company and General Instrument Corporation, which are the joint plaintiffs in an action now pending in the District Court of the United States, Southern District of California, Central Division, and entitled: Radio Condenser Company and General Instrument Corporation v. LeRoy J. Leishman, No. 4395 B. H.”

Exhibit M, referred to in Finding 20, *supra*, was one of the two specially constructed models furnished to counsel for the defendant in the Oklahoma action by the plaintiffs in the present action.

### XIII.

Defendant alleges that by participating in the defense and control of said action in the Western District of Oklahoma, the plaintiffs herein are bound by the outcome of that suit; and accordingly they are not entitled to any declaratory relief or any relief whatever, since the devices held to be infringements of said claims 7, 8, 9, 10 and 11 of reissue patent No. Re. 20,827 in said action in the [226] Western District of Oklahoma are identical with those specified in paragraphs 4 and 6 of plaintiffs’ complaint herein, and were of plaintiffs’ manufacture.

## PRAYER

In addition to the prayers for relief in defendant's original counterclaim and defendant's first supplemental counterclaim, the defendant further prays that the court adjudge that the plaintiffs are bound by the decision of the U. S. District Court for the Western District of Oklahoma in the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action No. 2155.

LeROY J. LEISHMAN,  
Defendant.

Dated, Los Angeles, California, July, 1946.

(Affidavit of Service by Mail.) [227]

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[Title of District Court and Cause.]

FINDINGS OF FACT AND CONCLUSIONS  
OF LAW

This cause having come on for hearing on plaintiffs' motion for summary judgment that plaintiffs' Radio Condenser Company Model 28 tuner and plaintiffs' General Instrument Corporation Model 31 tuner do not infringe Claims 7, 8, 9, 10 or 11 of United States Reissue Letters Patent No. 20,827; and the Court having considered the pleadings and files in the action, the admissions of defendant, plaintiffs' affidavits in support of said motion and defendant's affidavits in opposition thereto, the exhibits filed on behalf of plaintiffs and defendant, and

having heard the oral arguments of the respective parties,

Now, Therefore, the Court, pursuant to Rule 52 of the Rules of Civil Procedure, makes the following Findings of Fact and Conclusions of Law: [228]

## FINDINGS OF FACT

### 1.

Plaintiff, Radio Condenser Company, is a New Jersey corporation having its principal place of business at Thorne and Copewood Streets, in the City and County of Camden and State of New Jersey.

### 2.

Plaintiff, General Instrument Corporation, is a New Jersey corporation having its principal place of business at 829 Newark Avenue, in the City of Elizabeth and State of New Jersey.

### 3.

Defendant, LeRoy J. Leishman, is a citizen of the State of California and resides in the City of Los Angeles, California, and is the owner of United States Reissue Letters Patent No. Re. 20,827.

### 4.

Plaintiffs are manufacturers of radio condensers and tuners which are sold by plaintiffs to radio set manufacturers throughout the United States and which condensers and tuners are installed and em-

bodied by such radio set manufacturers in radio sets sold by them to distributors throughout the United States.

## 5.

Prior to the filing of the complaint in this action, defendant notified plaintiffs, in the year 1938, and each of said plaintiffs, of their alleged infringement of said United States Reissue Letters Patent No. Re. 20,827 by the manufacture, use, and sale of radio condensers and tuners.

## 6.

No action was commenced by the defendant against the plaintiffs, or either thereof, for their alleged infringement of defendant's United States Reissue Letters Patent No. Re. 20,827 [229] by the manufacture, use, or sale of radio condensers and tuners.

## 7.

Galvin Manufacturing Corporation, of Chicago, Illinois, a corporation of Illinois, purchased radio condensers and tuners from each of the plaintiffs and installed or embodied the same in radio receiving sets, which sets it sold to its distributors.

## 8.

The Richards and Conover Company, a corporation of Missouri, having a place of business in the City of Oklahoma City, State of Oklahoma, is a distributor of the said Galvin Manufacturing Corporation and purchased, sold, and distributed radio



sets in which were installed or embodied the said radio condensers and tuners manufactured and sold by each of the plaintiffs.

## 9.

Prior to the filing of the instant action, defendant filed an action against the aforesaid distributor, The Richards and Conover Company, in the United States District Court for the Western District of Oklahoma, Civil Action No. 2155, charging infringement of said Reissue Letters Patent No. Re. 20,827, and particularly Claims 7, 8, 9, 10 and 11 thereof, by reason of the selling or causing to be sold and using or causing to be used by the said The Richards and Conover Company, within said suit district, of certain radio receiving sets, referred to in the complaint of said suit as Motorola sets, of which Models 25F, 26C, 26C-7, 27D, 28-O, 30-F, 29B, 29B-6 are typical examples.

## 10.

Certain of the aforesaid recited Motorola radio receiving sets embodied or had installed therein radio condensers and tuners known as Radio Condenser Company Model 28 tuners, which were manufactured by the plaintiff, Radio Condenser Company, and sold [230] by it to the said Galvin Manufacturing Corporation.

## 11.

General Instrument Corporation Model 31 tuners, manufactured by the Plaintiff, General Instrument Corporation, and sold by it to the said Gal-

vin Manufacturing Corporation, are in all respects substantially the same as said Radio Condenser Company Model 28 tuners.

## 12.

One of the Radio Condenser Company Model 28 tuners and one of the General Instrument Corporation Model 31 tuners have been filed with the Complaint in the instant action, identified as Plaintiff's Exhibits 2 and 4, respectively.

## 13.

Drawings of the Radio Condenser Company Model 28 tuner and the General Instrument Corporation Model 31 tuner have been filed with the Complaint in the instant action, identified as Plaintiffs' Exhibits 1 and 3, respectively.

## 14.

United States Reissue Letters Patent No. Re. 20,827 relates to a device which operates to tune a radio circuit upon the manual depression of a lever which causes a radio condenser shaft to assume a predetermined position.

## 15.

Claims 7, 8, 9, 10 and 11 of such patent are involved in this action.

## 16.

Radio Condenser Company Model 28 tuner and General Instrument Corporation Model 31 tuner are

devices which operate to tune a radio circuit upon the translation of a push-button or plunger which causes a radio condenser shaft to assume a predetermined position, and are in all material respects substantially the same. [231]

## 17.

In the case of *Leishman v. Associated Wholesale Electric Co.*, reported in 137 F. 2nd 722, the Circuit Court of Appeals for the Ninth Circuit held that Claims 7 to 11, inclusive, of Reissue Letters Patent No. Re. 20,827 were not infringed by a device admittedly substantially the same as Radio Condenser Company Model 28 tuner and General Instrument Corporation Model 31 tuner.

## 18.

No evidence has been presented to the court by defendant which could in any manner change or affect the ruling of the Circuit Court of Appeals in the aforesaid case that plungers and levers in the alleged patented combination do not function in the same way, or in substantially the same way, and are therefore not equivalents.

## 19.

There is no genuine issue as to any material fact and no controversial question of fact to be determined at a trial respecting the issue of infringement of Claims 7 to 11, inclusive, of Reissue Letters Patent No. Re. 20,827 by plaintiffs' Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner.

## CONCLUSIONS OF LAW

1.

An actual controversy exists between the parties to the instant action.

2.

The court has jurisdiction of the subject matter and parties.

3.

No genuine issue as to any material fact exists in the [232] instant case respecting infringement by plaintiffs' manufacture, use, or sale of radio tuners.

4.

Plaintiffs' Radio Condenser Company Model 28 tuner and plaintiffs' General Instrument Corporation Model 31 tuner do not infringe Claims 7, 8, 9, 10 or 11 of United States Reissue Letters Patent No. Re. 20,827.

5.

Plaintiffs are entitled to a judgment:

(a) That plaintiffs have not infringed Reissue Letters Patent No. Re. 20,827, particularly Claims 7 to 11, inclusive, thereof, by the manufacture, use, or sale of condensers and tuners as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner;

(b) Enjoining and restraining defendant, his attorneys, agents, servants, employees, associates, and confederates from asserting, contending, claiming, or alleging that Reissue Letters Patent No. Re.

20,827 has been or is being infringed by plaintiffs, or either of them, or by the condensers and tuners manufactured, used, or sold as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner;

(c) Enjoining and restraining defendant, his attorneys, agents, servants, employees, associates, and confederates from asserting, contending, claiming, or alleging that the use and sale of condensers and tuners manufactured by plaintiffs, as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner, has been or is an infringement of Reissue Letters Patent No. Re. 20,827, particularly Claims 7, 8, 9, 10 or 11 thereof;

(d) Enjoining and restraining defendant, his attorneys, agents, servants, employees, associates, and confederates from prosecuting any action in law or equity in which condensers and [233] tuners manufactured by plaintiffs, as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner, are asserted to have been or are an infringement of Reissue Letters Patent No. Re. 20,827, particularly Claims 7, 8, 9, 10 or 11 thereof; and

(e) For their costs in this action.

Dated this 30th day of August, 1946.

[Seal]        /s/ C. E. BEAUMONT,  
                                 Judge. [234]

[Affidavit of Service by Mail.]

[Endorsed]: Filed Aug. 30, 1946. [235]



In the United States District Court, Southern  
District of California, Central Division

No. 4395-B—Civil

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,  
Plaintiffs,

vs.

LeROY J. LEISHMAN,

Defendant.

### JUDGMENT

This cause having come on to be heard on plaintiffs' motion for summary judgment that Claims 7 to 11, inclusive, of Reissue Letters Patent No. Re. 20,827 are not infringed by the manufacture, use, or sale of condensers and tuners, as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner; and the court having made and entered its Findings of Fact and Conclusions of Law and found that there is no genuine issue as to any material fact respecting infringement by the plaintiffs' said tuners, and having concluded that plaintiffs are entitled to judgment as a matter of law;

It Is Hereby Ordered, Adjudged and Decreed as follows: [236]

1. That the plaintiffs have not infringed United States Reissue Letters Patent No. Re. 20,827, par-

ticularly Claims 7 to 11, inclusive, thereof, by the manufacture, use, or sale of condensers and tuners as exemplified by Radio Condenser Company Model 28 tuner, filed with the complaint in this action as Plaintiffs' Exhibit 1, or General Instrument Corporation Model 31 tuner, filed with the complaint in this action as Plaintiffs' Exhibit 3;

2. That defendant, LeRoy J. Leishman, his attorneys, agents, servants, employees, associates, and confederates be and they are hereby enjoined and restrained from asserting, contending, claiming, or alleging that said Reissue Letters Patent No. Re. 20,827 has been or is being infringed by the plaintiffs, or either of them, or by the condensers and tuners manufactured, used, or sold by the plaintiffs, or either of them, as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner;

3. That said defendant, LeRoy J. Leishman, his attorneys, agents, servants, employees, associates, and confederates be and they are hereby enjoined and restrained from asserting, contending, claiming, or alleging that the use or sale of condensers and tuners manufactured by plaintiffs, or either of them, as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner, has been or is an infringement of Reissue Letters Patent No. Re. 20,827, particularly Claims 7, 8, 9, 10 or 11 thereof;

4. That said defendant, LeRoy J. Leishman, his attorneys, agents, servants, employees, associates,

and confederates be and they are hereby enjoined and restrained from prosecuting any action in law or equity in which condensers and tuners manufactured by plaintiffs, or either of them, as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation [237] Model 31 tuner, are asserted to have been or to be an infringement of Reissue Letters Patent No. Re. 20,827, particularly Claims 7, 8, 9, 10 or 11 thereof;

5. That a writ of injunction issue forthwith against the defendant, LeRoy J. Leishman, his attorneys, agents, servants, employees, associates, and confederates, in accordance with paragraphs 2, 3, and 4 hereof; and

6. That plaintiffs have and recover from defendant their costs in this action, the taxation of such costs to await the entry of judgment on the defendant's counterclaims herein.

Dated this 30th day of August, 1946.

[Seal]        /s/ C. E. BEAUMONT,  
Judge. [238]

[Affidavit of service by mail.]

[Endorsed]: Filed Sept. 12, 1946. [239]

[Title of District Court and Cause.]

NOTICE BY CLERK OF ENTRY OF  
JUDGMENT

You are hereby notified that Judgment has been entered this day in the above-entitled case, in Civil Order Book No. 39, page 656.

Dated Los Angeles, California, Sept. 12, 1946.

EDMUND L. SMITH,  
Clerk.

By R. B. CLIFTON,  
Deputy Clerk.

Mailed 9/13/46. [241]

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[Title of District Court and Cause.]

ORDER EXTENDING TIME IN WHICH TO  
FILE MOTION UNDER RULE 52(b)

For good cause shown, and as provided in Rule 6(b) of the Rules of Civil Procedure, the defendant is hereby given up to and including October 16, 1946, to file a motion under Rule 52(b) to amend the findings, conclusions of law and judgment.

C. E. BEAUMONT,  
United States District Judge.

Dated, Los Angeles, California, September 16, 1946.

[Endorsed]: Filed Sept. 17, 1946. [242]

[Title of District Court and Cause.]

### WRIT OF INJUNCTION

The President of the United States of America, to  
LeRoy J. Leishman, his attorneys, agents, servants,  
employees, associates and confederates:  
Greeting:

Whereas said Radio Condenser Company and said General Instrument Corporation have filed in the above-entitled court their complaint against said LeRoy J. Leishman for a Declaratory Judgment that United States Reissue Letters Patent No. 20,827 were not infringed by the plaintiffs or either of them; that said Letters Patent is invalid and void and for an injunction enjoining said LeRoy J. Leishman, his attorneys, agents, servants, employees, associates and confederates from further asserting, contending, claiming or alleging that said Reissue Letters Patent No. 20,827, or any claim thereof, has been infringed by [243] the plaintiffs, or either of them, or by radio condensers or tuners which were manufactured and sold by the plaintiffs, or either of them, or installed in radio receiving sets by any of their customers; and

Whereas, on the 12th day of September, 1946, a Final Judgment was made in the above-entitled action decreeing and adjudging that the plaintiffs have not infringed Reissue Letters Patent No. 20,827, particularly claims 7 to 11, inclusive, thereof, by the manufacture, use, or sale of condensers and tuners as exemplified by Radio Condenser Com-



pany Model 28 tuner, filed with the Complaint in the above-entitled action as Plaintiffs' Exhibit 1, or General Instrument Corporation model 31 tuner, filed with the Complaint in the above-entitled action as Plaintiffs' Exhibit 3 and that an injunction issue out of and under the seal of this court permanently enjoining and restraining said LeRoy J. Leishman as set forth in said Judgment.

Now, Therefore, we do strictly command and enjoin you, the said LeRoy J. Leishman, your attorneys, agents, servants, employees, associates, and confederates, and each of you from:

1. Asserting, contending, claiming, or alleging that said Reissue Letters Patent No. Re. 20,827 has been or is being infringed by the plaintiffs, or either of them, or by the condensers and tuners manufactured, used, or sold by the plaintiffs, or either of them, as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner;

2. Asserting, contending, claiming, or alleging that the use or sale of condensers and tuners manufactured by plaintiffs, or either of them, as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner, has been or is an infringement of Reissue Letters Patent No. Re. 20,827, particularly Claims 7, 8, 9, 10 or 11 thereof;

3. Prosecuting any action in law or equity in which [244] condensers and tuners manufactured

by plaintiffs, or either of them, as exemplified by Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner, are asserted to have been or to be an infringement of Reissue Letters Patent No. Re. 20,827, particularly Claims 7, 8, 9, 10 or 11 thereof.

Whereof, Fail Not in penalty of the laws thence ensuing.

Witness the Honorable C. E. Beaumont, Judge of the District Court of the United States this . . . . day of September, 1946, and in the One Hundred and Seventy-first year of the Independence of the United States of America.

[Seal]

EDMUND L. SMITH,  
Clerk.

E. M. ENSTROM, JR.,  
Deputy Clerk.

[Affidavit of Return on service of writ attached.]

[Endorsed]: Filed Sept. 18, 1946. [245]

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[Title of District Court and Cause.]

MOTION UNDER RULE 52(b)

Now comes the defendant, LeRoy J. Leishman, and moves under the provisions of Rule 52(b) of the Rules of Civil Procedure that this Honorable Court strike out the present findings, conclusions and judgment and substitute the attached set of

proposed findings, conclusions and judgment in their stead.

In the event that this Honorable Court for any reason should not make the substitution above requested, the defendant moves under the provisions of the said Rule 52(b) that the judgment and the injunction be amended as hereinafter specified:

That paragraph 2 and 3 of the judgment be stricken out;

That paragraph 4 of the judgment be amended by adding [247] the following sentence: "This paragraph shall not be construed to mean that the defendant is enjoined from any proceedings connected with, or resulting from, the present action or the case of LeRoy J. Leishman vs. The Richards and Conover Company, Civil Action No. 2155, in the United States District Court for the Western District of Oklahoma; and the defendant is not enjoined from proceedings against the Galvin Manufacturing Company, which admittedly defended the Oklahoma suit, and which is bound thereby according to the findings therein."

That paragraphs 1 and 2 of the injunction (lines 20 to 31, page 2) be stricken out; and

That paragraph 3 of the injunction be amended by adding the same sentence requested to be added to paragraph 4 of the judgment.

/s/ LeROY J. LEISHMAN,  
Defendant.

Dated, Los Angeles, Calif., October 16, 1946.

## NOTICE OF HEARING

Notice is hereby given that the defendant will call up defendant's Motion under Rule 52(b) for hearing in the courtroom of the Honorable Judge Beaumont on October 28, 1946, at 10 a.m., or as soon thereafter as the defendant and counsel for the plaintiffs may be heard.

LeROY J. LEISHMAN.

Dated, Los Angeles, Calif., October 16, 1946.

[Endorsed]: Filed Oct. 16, 1946. [248]

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[Title of District Court and Cause.]

## AFFIDAVIT AND CERTIFICATION

State of California,  
County of Los Angeles—ss.

LeRoy J. Leishman, being duly sworn, deposes and says:

That he attended the trial of the suit of LeRoy J. Leishman vs. The Richards and Conover Company, Civil Action No. 2155, in the United States District Court for the Western District of Oklahoma, held on April 29, April 30, and May 1, 1946; that Defendant's Exhibit 17, filed herewith, is a photostatic copy of portions of the official court reporter's transcript of the trial of the said suit; and that the said portions of [249] the transcript constitute an accurate record of those parts of the proceedings, excepting for obvious stenographic errors.

/s/ LeROY J. LEISHMAN.

Subscribed and sworn to before me this 16th day of October, 1946.

BEATRICE BURGER,

Notary Public in and for the County of Los Angeles,  
State of California.

My Commission Expires March 25, 1950. [250]

### DEFENDANT'S EXHIBIT 17

The Court: You are satisfied these are the patents?

Mr. Flam: If Mr. Mueller says they are copies we will agree.

The Court: 827 is the reissue.

Mr. Mueller: I might just tell your honor that the original of the patent which was reissued is also in there for your information. You see, as Mr. Flam pointed out, they had this patent, 2108538, and then under the reissue statute, which he explained to you, they reissued it into that patent, so for your information, both copies are in court. Now again, to save time, and help you on your request of April third, and again today, that you be kept well informed as we go along, I would like to adopt the procedure of offering in evidence quite a number of the defendant's exhibits, and I am doing that rather than merely marking them because some of them I think Mr. Flam will permit to be introduced, and if he has any objection possibly we can help you to straighten it out more quickly right away. It will amount to a stipulation in the beginning and give



you the benefit of the record, so I will run right down through these if I may.

Defendant's Exhibit E is a booklet of prior patents set up in the defendant's answer. This conforms with the answer and they are all clean copies. I will offer that in evidence. [251]

Mr. Flam: I presume those are the patents that have been cited in both answers.

Mr. Mueller: Yes, Exhibit E contains the prior art patents against the reissued patent set up in the original answer.

Defendant's Exhibit F, which I will offer in evidence now, is all of the prior art set up in the original answer and in the amendment to the answer.

Mr. Flam: All of them are included that are in the answer?

Mr. Mueller: Yes.

The Court: What is Exhibit F?

Mr. Mueller: Exhibit F contains the prior art patents against 282 patents.

Mr. Flam: Are they offered in evidence?

Mr. Mueller: They are offered in evidence.

Mr. Flam: No objection.

Mr. Mueller: I will also offer in evidence Defendant's Exhibit G, which is a model of the tuner, Model 28, manufactured by Radio Condenser Company and sold to Galvin, and incorporated in some of the radio sets in suit.

Mr. Flam: May I make this amendment? Exhibit G is an exemplary of the tuner mechanism and

the sets that have been set up in plaintiff's complaint as the accused sets?

Mr. Mueller: Yes, sir. [252]

Mr. Flam: Except possibly a variation in the number of actual push button devices.

Mr. Mueller: That is satisfactory. It is unimportant to the issues in the case.

Mr. Flam: I presume as to the next one the same understanding can apply?

Mr. Mueller: Yes. I offer Defendant's Exhibit H in evidence.

The Court: H is a General Instrument device?

Mr. Mueller: H is General Instrument. The, Defendant's Exhibit I, which I offer in evidence, is one of the Crosley tuners and is an exemplar of the Crosley tuner which was in the Associated Wholesale case in California. That does not have a condenser on it, but as I explained, that just happens to be that way. The plaintiff has already in evidence drawings, I believe they are his Exhibits 1 and 3, that correspond with Defendant's Exhibits G and H. I am going to offer in evidence a third drawing, Defendant's Exhibit J which is prepared in the same manner as Plaintiff's Exhibits 1 and 2 and corresponds to the Crosley tuner, Defendant's Exhibit I.

The Court: Let me understand that. 1 and 3 of his are the same as G and H of yours?

Mr. Mueller: Yes.

The Court: What is the same as your I?

Mr. Mueller: Defendant's Exhibit J is the same as [253] Defendant's Exhibit I.

The Court: You mean Plaintiff's Exhibit J?

Mr. Mueller: No, defendant's. The drawing, J, is the same as the physical model, I. I am offering in evidence Defendant's Exhibit K, a model of a Zenith radio tuner, a tuner manufactured by the Zenith Radio Corporation of Chicago, and it corresponds to the structure of the Schaefer patent.

The Court: What is the Schaefer patent? This is the first time I have heard of it.

Mr. Mueller: The Schaefer patent is one of the prior art set up against the 20827, the reissued patent, and the Schaefer patent 1906 is owned by the Zenith Radio Corporation. This is a tuner, which, for all practical purposes, was put out under that patent.

The Court: If, as you contend, these patents here are invalid because of prior ones, would not this be an infringement on this?

Mr. Mueller: No, because there were no claims in the Schaefer patent, so far as I know, that are infringed by any of these three sets, Defendant's Models, I, G, and H. I might say practically all radio manufacturers are licensed to use the Schaefer patent through a patent of the RCA Hazelton Corporation. Infringement, so far as Galvin is concerned, will not come up on the Schaefer [254] patent, because we are already licensed under it. Zenith made arrangements with Hazelton to make RCA years ago, so there will never be a question on that particular one.

I also offer in evidence Defendant's Exhibit L. This is an exemplar, as Mr. Flam calls it, of a

portion of the Marschalk patent, No. 2072897, which is in our prior art against the reissued patent. It corresponds to Figure 14 of Sheet 3 of the drawings. I might also explain here—Mr. Flam can point out any objection he has—Figure 14 of the Marschal patent shows the lever being operated by an electric solenoid. We have no facilities for it, that is, that electric solenoid, so we have merely put a finger button on, and it can be operated by the hand in exactly the fashion that lever can.

Mr. Flam: I wish to reserve any objection I may desire to make to this model, or the introduction of it in evidence, when the case proceeds. I want that understood in connection with all of these exhibits that have been introduced. I don't think I will have any but I am not sure.

The Court: This Zenith, what patent does that refer to?

Mr. Mueller: Schaefer Patent 1906.

The Court: Exhibit K.

Mr. Mueller: Exhibit K. For the purpose of this suit and an explanation as illustrative of the defendant's position on invalidity, we have a model, Defendant's Exhibit [255] M, which combines, as we will later show, a lever out of the Marschalk patent, a lever out of the Schaefer patent, 1906106, and a rocker or rotary treadle out of Marschalk patent, 20772897. Mr. Flam may want to observe objection. I can understand that, and we will elaborate on that. This is introduced at this time for your assistance; that is all. I will go in to that in presenting the defendant's case.



Mr. Flam: We would urge that it is not a proper combination of the two patents.

Mr. Mueller: The next model, and I offer this in evidence as Defendant's Exhibit N. This is a Motorola radio set, Model 19-B, which was specified in the bill of complaint. This is one of the models which is alleged to infringe the 282 patent. We have been talking about the reissue up to now. This is alleged to infringe the 282 patent, and this is Defendant's Exhibit N. The housing is off; otherwise, it would be an auto radio set much as you have in your car, for operating purposes, at least.

Mr. Flam: In that connection, of course, we can stipulate that set has the number of push buttons and so on; the fundamental elements for taking the play out of the gear would be the same in all the accused models that have been accused of being infringements.

Mr. Mueller: Those that have it. Some of them don't have it. I sent those out here but they haven't arrived. [256] Some of the models accused to infringe do not have the anti back lash of this model.

Mr. Flam: Attention may also be called to the fact that back lash operates on this model.

Mr. Mueller: That is purely a matter of opinion. I am sure it will work very well just as it is. Nothing has been done to it. It is exactly the way it was taken out of the store. If you feel it is not in proper shape, of course, that is your opinion and perfectly all right.

Mr. Leishman: It is not working right because the spring is not pulling the gear back.



Mr. Mueller: If you want to fix it all right. I can assure you there is no intention of taking any advantage.

Mr. Flam: I am not accusing any one. I merely wanted the Court to understand.

The Court: This little thing here is 282?

Mr. Mueller: Yes, sir.

Mr. Flam: The mechanism relating to that advice for taking back lash out of gear in connection with the tuning device.

The Court: Were these same gears here before the mechanism here was used? Do you know what I mean by that?

Mr. Mueller: Gear trains have been used for years.

The Court: And were used on these sets?

Mr. Mueller: Here is the way it works out. Every model, and we used to come out with two different lines [257] each year, and each model is laid out somewhat different mechanically so you can't draw comparisons without having something right before you. This would serve as an example of the tuning and gear train mechanism on the sets identified in the bill of complaint relative to the 282 patent, but they might each one be different, as you will see, when those show up from the express company.

The Court: I think a search should be made for them.

Mr. Mueller: I am going to do that at noon.

The Court: If we don't get them I understand there is plenty of evidence here.

Mr. Mueller: I am particularly concerned because they are the only models at Galvin. We have no others that will show up in the future just what this mechanism is, so I am very concerned about them.

The Court: Does that complete your statement?

Mr. Mueller: I might just state on this question of back lash Mr. Flam referred to in his opening statement. It is our position that taking out back lash with a train of gears is merely a common expedient which the draftsmen of any radio concern are fully familiar with, and they use various means, and we take the position that what we have in this set is not an infringement of the 282 patent. We will show you that, but assuming for the purposes of argument you hold claims 7 and 11 in the 282 patent infringed, [258] we contend and urgently submit that they are invalid as representing nothing more than the ordinary mechanical work of a draftsman.

The Court: Nothing novel about it?

Mr. Mueller: Nothing novel or arising to an inventive degree. As I say, I would like to reserve a few minutes of my opening statement to help you, if it is necessary, before putting in the defense after Mr. Flam has put in his case.

LeROY J. LEISHMAN

the plaintiff, being duly sworn, testified as follows:

Direct Examination

By Mr. Flam:

Q. Mr. Leishman, are you the plaintiff in this action?      A. Yes, sir, I am.

Q. What is your age?      A. 50.

Q. What is your occupation?

A. I am an engineer.

Q. What kind of an engineer?

A. Well, I have done work as a mechanical engineer; radio engineer and electrical engineer.

Q. When did you first become interested in the subject of radio? [259]

PROCEEDINGS

May 1, 1946, 8:30 o'Clock a.m.

M. F. SPOTTS

called as a witness on behalf of the defendant, out of the regular order by agreement, being duly sworn, testified as follows:

Direct Examination

By Mr. Mueller:

Q. You may state your name for the record.

A. M. F. Spotts.

Q. Please state your age and residence.

A. My age is 50. Resident, Evanston, Illinois.

Q. What is your present occupation, and will you also state your academic background?

A. I am an associate professor of machine design at Northwestern University, Evanston, Illinois. I graduated in mechanical engineering at Ohio Northern University in 1923; received a Master of Arts degree at Ohio University in 1933, and a Doctor of Philosophy degree from the University of Michigan in 1938.

Q. Did you do some teaching during that period?

A. I taught two years at the University of Michigan part time while a student. From 1938 to 1941 I was a teacher at Johns Hopkins University, Baltimore, Maryland. From 1941 to the present date I have been at Northwestern.

Q. What commercial experience have you had in mechanical designing and engineering, and please name some of the [260] companies and the dates of your activities.

A. Before becoming a teacher I worked five years for the Brown Steel Company, Columbus, Ohio, 1927 to '32. I worked two years for the Jeffry Manufacturing Company, Columbus, Ohio, '33 to '35.

Q. You might just mention your last occupations?

A. Since starting to teach I have done rather wide consulting work for various industrial firms.

Q. Are you consultant for the Galvin Manufacturing Company in Chicago?      A. I am.

Q. How long have you been such consultant and what are your general duties?

A. I have been with Galvin in this capacity for about three and a half years. My general duties are to assist the engineering, designing and research

departments in the development of their products. I work mostly with the engineers assisting in designs and helping to improve them; making the operation of the devices better and getting the designs in condition for the most economical commercial production.

Q. What are those products with which you have been working in general?

A. Radio equipment in general and the development of a gasoline burning automobile heater which is being developed; I also have worked some on the development of an automatic washing machine.

Q. Has the major part of your activity, however, been confined to radio equipment at Galvin's?

A. The major portion has been.

Q. In your work as engineer and as a mechanical designing consultant have you come in contact with draftsmen and designers who do the lay out work, over the years?

A. I have known many draftsmen during the last 15 years.

Q. Are you acquainted with the subject of tuning radios and with the mechanism used for accomplishing the tuning?

A. I understand the usual mechanism for that purpose.

Q. Are you familiar with patent drawings and patent specifications from a technical standpoint?

A. I have examined many patent drawings and have read the specifications for them.

Q. Have you ever testified as a witness in patent infringement cases or in any other litigation?



A. This is my first experience as a witness.

Q. Have you studied the Leishman patent, Reissue 20827, Marschalk 2072897 and Schaefer 1906106, and are you familiar with the drawings and specifications of those patents?

A. I have studied those drawings.

Q. Have you studied the specifications too?

A. Yes, sir.

Q. Have you seen the model, Defendant's Exhibit L and have [262] you compared it with Figure 14 of the Marschalk patent?

A. I have.

Q. Have you seen the model, Defendant's Exhibit K?

A. I have.

Q. And compared it with drawings in the Schaefer patent?

A. I have.

Q. Referring to this chart, which I have marked for identification, Defendant's Exhibit Y, you will see that Figure 2 of the Leishman reissue patent is enlarged and Figure 4 of the Schaefer patent is also enlarged on this chart. Is there any comparison in operation and function which you can make between the arms 48, colored green in Leishman and the arms, 32 and 34, colored green, in Schaefer as they operate with their respective tappets colored yellow?

A. Arms 48 of Figure 2 of Leishman and Plates 32 and 34 of Schaefer perform the same function so far as the tuning of a radio is concerned.

Q. What function do they perform so far as

setting up the tappet colored yellow and the tappet colored yellow in Figure 4 of Schaefer?

A. They serve the purpose of positioning the tappet at the time of adjustment of the mechanism.

Q. Can you make any comparison between the movement of the arms 48 in Leishman and the arms, 32 and 34 of [263] Schaefer with respect to the two tappets colored yellow in a setting operation for the tappets?

A. The movement of arms 48 and plates 32 and 34 serve to position the tappet. The vertical motion positions the ends of the tappet arms in adjusting the tappet.

Q. Is it the vertical motion of the two moveable portions, the arms 32 and 34 in Schaefer and 48 in Leishman?

A. It is the vertical movement which determines the positioning of the tappet.

Q. Is there a rotary movement in Leishman?

A. Because of the manner in which the Leishman arms 48 are mounted there is a rotary motion in addition to the vertical.

Q. The word coaxial has been used to describe the relation of the center for Leishman's tappet 61 and the center of his rocker 48. Do you find coaxiality present in the Schaefer structure, the Figure 4?

A. In effect there is coaxiality present. The axis, however, in the Schaefer may lie in the air, an imaginary line through the space between plates 32 and 34, and is not included in the physical embodiment but it is present.

Q. What is the relation between a line through the contact points of the tappet 56 of Schaefer and the arms 32 and 34 relative to the center 55 for the tappet 56?

A. A line through the center, 55, passes through the end points of the tappet 58 of the Schaefer mechanism and is so stated in the description of the apparatus.

Q. In the movement of the tappet 56 of Schaefer, as the arms 32 and 34 are moved, what happens to that line?

A. The angular position of the line would be changed as the plated 32 and 34 move backward and downward.

Q. Would that line have a center in this movement?

A. Yes, the line radiates about the center, 55.

Q. Is the principle and structure of coaxiality known or an unknown condition in mechanical design?

A. It is much used in mechanical devices.

Q. That is, there is nothing obscure about the principle and structure of coaxiality?

A. No. It is a well known and widely used principle; has been known a long time.

Q. I hand you a model, Plaintiff's Exhibit 30, which the plaintiff has stated corresponds to the structure of his reissue patent. Is there any necessity in the structure of the Leishman reissue patent for maintaining coaxiality of the parts, and will you explain your answer with reference to the models so the Court can understand?

A. In the Leishman patent where there are two tuning operations performed simultaneously, it is necessary that the pivots of rotation for both of the rockers be coaxial.

Q. Will you please point out those rockers?

A. The two rockers, being the one I am now holding, and the other one being the inner one which I am now holding, are tuned by coming in contact with the tappet when the lever is pushed. Each rocker is moved to a position in the usual way of such devices. It is when we combine two of them in a single device that it is necessary that the pivots for both of them lie on the same line, so that the axis of each coincides with the axis of the other. If you should make a scale drawing of the device you would see if that were not so that by the time one pair of points would come in tact with its rocker that the other two would not touch simultaneously. It would only touch on one side and leave a gap on the other, depending on the structure of your parts, so they would bind and it would be impossible to bring them into contact.

Q. In other words, in the Leishman structure of the reissue patent, is it necessary to have coaxiality of the two rockers which you have just shown to the court, and the two tappet parts on the lever in order to operate the device?

A. For the operation of the tuner it is so necessary.

Q. Can you make any comparison in operation and function between the two sides colored green,



for the rocker 34 of Marschalk on that chart, Exhibit Y, and the two arms, colored green, rocker 48, on Figure 2 of the Leishman patent? [266]

A. These aforementioned parts perform the same function in the tuning mechanism.

Q. What is that function? Explain the operation of those parts.

A. The function of rocker 34 of Marschalk and rocker 48 of Leishman is to rotate the condenser on a radio set and thus achieve tuning.

Q. In rotating the condenser on a radio set, what comparison can you make in the operation of the rocker itself, in the two devices?

A. The motion in the two devices is exactly the same. It is merely a rotation but it is pivoted.

Q. Will you kindly refer to Defendant's model, Exhibit M, which I hand you, and state whether that model corresponds with the lever in the Schaefer patent?

A. The lever in Exhibit M is substantially the same as lever 51 of Figure 4 in Schaefer.

Q. Will you kindly compare the treadle or rocker of this model, Defendant's Exhibit M, with the treadle or rocker 34, colored green in Figure 14 of Marschalk?

Mr. Flam: You may remember that when this model was offered in evidence I reserved objections to it. I want to reiterate that because it is quite obvious this model is supposed to represent a combination of elements which were taken from Marschalk, allegedly taken, which we deny. The lever mechanism itself is apparently a good deal [267]



like the Schaefer lever, but authorities, which I shall refer to here in a moment, say that the elements of a combination may be old. It is the combination of old elements that produce a different result which makes an invention. Now that model, especially the rocker——

Mr. Mueller: If you will wait until I examine the witness I think those things will be covered. We have not offered it in evidence. I will bring out all the objections. We are not attempting to mislead the court.

Mr. Flam: We have no argument about whether this witness will testify truthfully or not. I am quite sure he will. The main point of my objection is that if this witness now says that it is not a proper representation, or proper combination of these two showings, then right now there is no pertinence to his testimony.

Mr. Mueller: I don't quite understand that. I think it is perfectly proper to combine references in any way one wishes. I have never found any law to the contrary. It is done every day in the patent office and every day in the courts. The question is whether the combination, as a matter of law then anticipates and makes the alleged invention of the patent in suit an obvious combination and expedient. That is the question for the court to decide.

The Court: I think I understand. Mr. Flam, I will let you ask that question you asked, if there are representative parts of each one. [268]

Q. (By Mr. Flam): Doctor Spotts, the rocker now incorporated in the model, Exhibit M, that

rocker corresponds in structure to the rocker of the Marschalk patent, Figure 14?

A. It does in some respects. There are some differences.

Mr. Flam: I object to this line of testimony on the basis of that answer.

The Court: I will overrule the objection but I will take it into consideration. I think I understand the situation.

Mr. Mueller: This, your honor, as I explained, is for the purpose of illustration to help you, and we are not contending that it is an exact reproduction of the Marschalk treadle.

The Court: I understand. You may proceed.

Mr. Mueller: You will recall Mr. Leishman presented a number of charts where he made certain representations as to differences——

Mr. Flam: We didn't combine prior structures to suit our case.

The Court: I don't think I will be misled by it.

Mr. Flam: I am quite sure you will not, but I don't think that model is properly exhibitable in evidence. Your honor may receive it; possibly you should have the record complete, but I am quite sure, upon mature consideration, your honor will say there is no basis for that exhibit [269] in this case at all.

The Court: It is your contention here are some elements of one patent and another combined and it is admitted the parts here supposed to be representing one of the patents are not like the one on that patent.

Mr. Flam: They admit that.

The Court: I want to be sure what they are driving at. I am sure I will not be misled by it.

Q. (By Mr. Mueller): Doctor Spotts, will you please compare the treadle or rocker of this model, Defendant's Exhibit M, with the treadle or rocker 34 in Figure 14 of Marschalk and tell the court where it corresponds and where it differs?

A. The rocker of the model which I hold in my hand, Exhibit M, consists of a plate mounted by tappets at each end. The mounting of the plate is such that the upper surface apparently is exactly at the mid-point at the axis of the shafts by which it is mounted. A careful consideration of Figure 14 of Marschalk indicates that the upper surface of the plate is not quite on the center line. In addition, the plate on the model I hold in my hand has a square hole cut in the center of it. Those, apparently, are the chief points of difference.

Q. (By the Court): You mean the Marschalk doesn't have a hole?

A. No, sir. So far as we can learn from looking at the [270] drawing.

Mr. Flam: I would like to interpose a question regarding this model.

Q. (By Mr. Flam): Did you make that model or was it made under your supervision?

A. No. I didn't have anything to do with the making of the model.

Mr. Mueller: I might explain that I borrowed that model because I didn't have time to make up

representations myself. If I had been doing it I would have had other models, your honor.

The Court: You may proceed.

Mr. Mueller: I will be glad to tell where I got it. I borrowed it from counsel for the General Instrument Corporation because they had made up models and I was not able to engage the time of a mechanic to make them myself. These things, the same as papers, are handed back and forth between counsel.

Q. (By Mr. Mueller): Then, Doctor Spotts, can we say that in the model, Defendant's Exhibit M, the shaft has been moved one-half the thickness or shall we say the center of the shaft is one-half the thickness of the rocker or treadle in the model relative to the position of the shaft in the treadle or Figure 14 of Marschalk?

A. That is the conclusion we would draw by an examination of both the model and drawing. [271]

Q. In other words, it is just one-half the thickness away from what it is in the drawing?

A. That would seem to be the situation.

Q. What, in your opinion, do these differences, this removal of the shaft axis one-half the thickness of the plate, and the introduction of a hole in the treadle, represent from the mechanical design standpoint?

Mr. Flam: I think the question is so indefinite this witness might answer most anything. If it is desired to bring out that these are mere mechanical changes that a mechanic can make, then we are faced



with this problem: we don't know who instructed such a mechanic to make them, or in the first place, to instruct a mechanic to combine these two devices. I want to get this picture before your honor. The contention by the defendant apparently is this: That to arrive at Leishman you have to combine the teachings of Marschalk and of Schaefer and when you combine the teachings why you must perforce get at the plaintiffs' model. Now, supposing a mechanic is faced with that problem and some highly skilled engineer for an inventor says: "I want you to incorporate the lever of Schaefer with the rocker of Marschalk." Now the chances are he wouldn't know how to do it without further telling him: "Well, you put a hole in there." Well, of course, putting a hole in there doesn't amount to an invention, but it is that which must be done in the first place that [272] makes an invention.

Mr. Mueller: Doctor Spotts is here as an expert. We are giving the court the benefit of his testimony. He can accept it or reject it as he sees fit.

Mr. Flam: If your honor will hear me I think you will know the point I am driving at. If you face a mechanic with the task of combining these two devices, how does he know he should take the rocker of Marschalk rather than this up and down device of Schaefer. How does he know whether he should take the lever of Marschalk instead of the lever of Schaefer. There are two possible main combinations. He says: "Well, I have a choice there. I will take the lever of Marschalk and combine it with the up and down rocker of Schaefer or I will



take the lever of Schaefer and combine it with the rocker of Marschalk." You have at least those two major choices. Now here comes a witness who is going to say: "Well, of course, you can take the lever of Schaefer and you can take the rocker of Marschalk and you can combine them, and that involves the question of how it should be modified to appropriate the invention of this patentee.

The Court: You mean approximate?

Mr. Flam: To approximate or appropriate.

The Court: What do you mean by "appropriate?"

Mr. Flam: I don't like to use so harsh a word, but pirate the invention of the patentee. That is the question [273] this witness has been asked, taking the rocker from one thing and the lever from another and combining and making appropriate changes, and how it happens the same dimensions should be made in order to produce the same effects as in Leishman, and I raise the objection that is indefinite.

The Court: I understand what you have just said, and I am not going to be misled by it.

Mr. Mueller: We haven't expected you would.

The Court: I can see, without that explanation, that I could have been misled.

Mr. Mueller: I am glad he made the explanation, although we contend, of course, that such a combination is obvious, and of course, that is the purpose of having Doctor Spotts explain his position to you as an expert.

(Previous question read as follows: "What, in your opinion, do these differences, this removal of the shaft axis one-half the thickness of the plate, and the introduction of a hole in the treadle, represent from the mechanical design standpoint?")

Mr. Flam: Did your honor overrule the objection?

The Court: I think he can answer that.

A. (By the Witness): They would represent common sense in trying to combine the two elements together to get them to operate together; what one would have to do to get them to operate together.

Q. (By Mr. Mueller): Doctor Spotts, referring to Figure 4 on [274] the chart showing the Schaefer device, don't we have a manually operated lever in that case?

A. There is a manually operated lever in Figure 4 of Schaefer.

Q. Then if we were working on the problem of a mechanically operated tuner would it be proper to use the mechanically operated lever of Figure 4 of Schaefer?

Mr. Flam: I object to that as rather leading. In the first place, I don't know whether this expert testimony is the kind your honor would like any how. I would like to read from Corpus Juris, Page 350 on expert testimony. "It is for the judgment of the Court trying a patent case whether he needs the assistance of experts. In some districts certain rules

of court relating to the testimony of expert witnesses have been adopted for the purpose of confining experts to explanations which are helpful to the court in enabling it to understand the art. The opinion of an expert as to the construction of the patent in suit is not admissible." I grant this witness may properly testify and explain the prior art references, but when he encroaches on the province of the court in testifying whether it is proper or not to do this, that or the other, I don't think it is proper and I object on that ground.

The Court: Assuming I am the one to pass on whether or not it is obvious, how far could the testimony go, so I would know whether it was obvious or not, or am I limited [275] to just my sight or what?

Mr. Mueller: I could even refer to the record in the other case, and as the court pointed out, as I am sure you feel, that you can have the benefit of his testimony. You are acting as a judge and not a jury and you can accept or reject his opinion if you wish, and that is the purpose in patent cases.

The Court: That is the way I feel about it, and I would like to hear what this witness has to say and what his opinion is. It may be different from my opinion. I may disagree with him and I certainly reserve the right to, as to what is obvious and as to why things were done and so forth. I should think you could bring it out on cross-examination. The point is, he is not going to mislead me a bit. At least, I think he is not.

Mr. Flam: I am quite certain of that.

The Court: And I shall not hesitate to disagree with him because he is an expert, not that I think I am an expert, but I think I have enough common sense to tell whether or not his opinion is sound.

Mr. Flam: I think when you get through with this case you will be qualified as an expert.

The Court: I would like to know. If counsel did not ask him these questions I would, just to enlighten myself.

Mr. Flam: I wanted to make this objection of record. I want to get your remarks as well for everybody's purposes. [276]

The Court: And I would be glad to have your explanation as to what they are attempting to do in each instance, so I can be aware of what you contend they are trying to do, if they are trying to confuse or mislead me. They might be. I don't know.

Mr. Mueller: I hope you have no feeling to that effect. I couldn't present this thing more openly. Both Mr. Flam and I both credit you with intelligence in this matter, and the implausibility of the plaintiff's case seems to me, becomes quite apparent in their strenuous efforts to prevent that, which you can pass upon as any other man in your position can.

The Court: You may proceed. I want to hear what this man's opinion is about everything and I can assure the plaintiff that I shall not hesitate to disagree with him because he is an expert. I will disagree with him very freely unless I can see that he is correct.



Mr. Flam: I do not want to carry this argument further except to state, with Mr. Mueller's permission, my general objections to the testimony of this witness and questions of this character will hold, so I will not have to jump to my feet each time.

The Court: Yes, if it is satisfactory with Mr. Mueller.

Mr. Mueller: It is satisfactory.

The Court: You have an objection to this whole line [277] of testimony and the propriety of opinion evidence from an expert, and any objection you may have will apply to every question.

Mr. Flam: I don't want to be jumping up every second or so, and if that is understood I will interpose no further objections.

The Court: Yes. You may have an objection to all of this and an exception.

Q. (By Mr. Mueller): In the model, Defendant's Exhibit M, does the pivot point for the tappet or cam relate to the pivot for the rocker or treadle?

A. The axis of both parts would coincide when the lever is in a home position.

Q. Are they coaxial then?

A. That is the usual meaning of the term.

Q. Referring to this model, Defendant's Exhibit M, how does the operation for setting up the tappet relative to the rotary rocker compare with the same operation in Leishman, Figure 2?

A. The manual steps the operator would go through in setting the tappet in each of the devices would be identical.



Q. Then to substitute in Marschalk the exact lever from Schaefer, is it correct that all you would have to do is put a hole in the Marschalk treadle to accommodate the body of the tappet for a cam, or for a tappet on the lever? [278]

A. That is what one would have to do to make the lever of Schaefer operate on the rocker of Marschalk.

Q. (By the Court): And the effect of doing that, those changes or differences, the changes you make in combining them is to make them coaxial when it is in a home position, the lever with the rocker?

A. A man could do that even if he had never thought very strongly——

Q. Answer my question. That is the effect of it, isn't it? A. I suppose so, yes.

Q. In other words, the changes you made in Marschalk and Schaefer, in order to combine them, made this coaxial?

A. Yes. They became coaxial when you made the hole.

Q. And they would not have been coaxial if you had not made the change?

A. If you had not made the hole they would not be.

Q. (By Mr. Mueller)): The hole is a change.

A. Yes, the hole is a change. They also turned out to be coaxial—the combination turned out to be coaxial because each individual part was shaped in the manner it was. We could shape the separate

parts so when combined they would not be coaxial.

Q. (By the Court): Wouldn't they work just the same if they were not coaxial?

A. They would then probably work more like this model. [279]

Q. (By Mr. Flam): What is that model number? A. Model L.

Q. (By the Court): Is Model L the one that the tappet slips when you are setting, the rocker slips when you are setting? A. Yes.

Q. Whereas, if it were coaxial it wouldn't?

A. That is correct.

Q. (By Mr. Mueller): Is there a space or opening to accommodate the body of the tappet of Schaefer between the arms 32 and 34?

A. There is an air gap between the two arms.

Q. Supposing you told your students in mechanical designing that you wanted to use the lever assembly of Schaefer because it permitted setting by the operator's finger for station tuning by the tappet and you wanted to substitute this lever assembly in Marschalk for his solenoid driven lever, and then you asked your students to design for you a satisfactory tuner. Can you tell what you would expect to happen, from your experience?

A. I would expect the students to make scale drawings of the assembly of the two mentioned parts. Then they would observe that the end points, 57 and 58 of the tappet of Schaefer could not be brought into contact with the rocker of Marschalk

because of the material surrounding [280] the pivot for the tappet. I would say: "But I asked you to complete the design, so what must you do to finish it?" I would expect the students to merely cut a hole in the plate to provide clearance around the material surrounding the pivot so it could enter into the plate without touching on any side and thereby permit the ends 57 and 58 to come in contact with the plate.

Q. With the teachings of Schaefer and Marschalk before an ordinary machine or layout designer such as you have worked with in your commercial experience, will you please describe the design problem in providing settable tuning mechanism in the plunger if an adjustable cam thereon is to be used to actuate a rotary rocker connected to a tuning condenser?

A. The designer would look at the drawing of Marschalk and would observe the solenoid, he would note that if he merely omitted the solenoid and extended the lever a little farther and put a button on the end for finger operation, that there would be no change whatever in the operation of the mechanism. That is, if I got your question correctly.

Q. I was referring to a plunger instead of a lever; desiring to use a plunger rather than a lever but using the teachings of Marschalk and Schaefer?

A. If one wished to use a plunger that would give straight line motion as support for the tappet rather than the [281] pivoted lever which gives motion in the arc of a circle of a rather large radius, draftsmen would have no compunctions about sub-

stituting a plunger giving a straight line for the lever, giving an arc of a circle, since the motion is rather small while the tappet is being brought into contact with the rocker. A draftsman would make that substitution in the usual line of his work.

Q. (By the Court): Easy to do.

A. Oh, yes.

Q. It would impose no serious problem where a lever is used and you decided you wanted to use a plunger, to change the design to make it work with a plunger?

A. A draftsman does those things every day in the week in his usual line of work.

Q. (By Mr. Mueller): I think your answer to the Court was the answer to my next one, but for the purpose of the record to see whether you have anything else to add, will you answer this question: Is the design operation which you have just described a difficult problem so far as the plunger and the tappet and the rocker assembly is concerned?

A. My opinion would be from observing types of mechanisms which are in design as a matter of course in present-day industry, and the complications thereof, that this mechanism would be rated by a draftsman as rather a simple thing. [282]

Mr. Mueller: I offer in evidence the chart, Exhibit Y which has been referred to in this testimony.

The Court: It will be admitted.

Q. (By the Court): On this model, Plaintiff's

Exhibit 30, you were talking about the coaxiality of the two—what do you call that?

A. Rockers.

Q. Rockers, and you said it was necessary that the two rockers be coaxial because two tuning operations were done at once. If they were not coaxial it could not be done?

A. Yes, that is right.

Q. You did not mean to say that unless two tuning operations were being done it would not be necessary for the plunger and the one rocker to be coaxial to work, so that the rocker wouldn't move when you were setting it? You didn't mean to lead me to believe that if there were not two operations on here that it would not be necessary for the plunger and the rocker to be coaxial to get good results?

A. No, I didn't mean to leave it that way.

Q. Model L shows unless it is coaxial it moves while you are setting it?

A. Yes, that is right.

Mr. Mueller: You may cross-examine.

[Affidavit of service by mail.] [283]

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[Title of District Court and Cause.]

### ORDER

This cause having come on for hearing on defendant's Motion under Rule 52(b) of the Federal Rules of Civil Procedure and hearing having been



had and the Court being fully advised of the premises, it is hereby Ordered:

(1) Defendant's motion to file a supplemental Answer to the Complaint in this action and a second supplemental Counterclaim is denied.

(2) Defendant's Motion under Rule 52(b) is granted to the extent, and only to the extent, that the judgment in this cause shall be amended by the addition of a seventh paragraph to said judgment reading:

“This judgment shall not be construed to mean that the defendant is enjoined from proceeding in the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action No. 2155 [284] of the United States District Court for the Western District of Oklahoma, and defendant is not enjoined from proceeding against Galvin Manufacturing Company.”

/s/ C. E. BEAUMONT,  
Judge.

Enter: Dec. 18, 1946.

Judgment entered Dec. 18, 1946. Docketed Dec. 19, 1946. C. O. Book 41, Page 79.

EDMUND L. SMITH,  
Clerk,  
By FRANCIS E. CROSS,  
Deputy.

[Endorsed]: Filed Dec. 18, 1946. [285]

United States District Court

Office of the Clerk

Southern District of California

Room 231 Post Office Building,  
Los Angeles 12, California,  
December 19th, 1946.

Lyon & Lyon, Esqs.,  
Attorneys at Law,  
811 West Seventh Street,  
Los Angeles 14, Calif.

Gentlemen:

No. 4395-B. Civil. Radio Condenser Company,  
et al. vs. LeRoy J. Leishman.

Please be informed that order amending judgment, signed by Judge Beaumont, has been filed and entered in Civil Order Book 41, page 79, under date of December 18th, 1946, and docketed on December 19th, 1946.

Yours very truly,

EDMUND L. SMITH,  
Clerk,

By /s/ FRANCIS E. CROSS,  
Deputy. [286]

In the United States Circuit Court of Appeals  
for the Ninth Circuit

No. 4395-B Civil

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,  
Plaintiffs,

vs.

LEROY J. LEISHMAN,

Defendant.

NOTICE OF APPEAL TO THE CIRCUIT  
COURT OF APPEALS UNDER RULE 73(b)

Notice is hereby given that LeRoy J. Leishman, the defendant above named, hereby appeals to the Circuit Court of Appeals for the Ninth Circuit from the final amended judgment entered in this action on December 18, 1946.

/s/ LEROY J. LEISHMAN.

[Affidavit of service by mail attached.]

[Endorsed]: Filed March 17, 1947. [287]

In the United States District Court, Southern District of California, Central Division

No. 4395-B Civil

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT CORPORATION,  
Plaintiffs,

vs.

LEROY J. LEISHMAN,

Defendant.

TENDER OF CASH DEPOSIT IN LIEU OF  
BOND ON APPEAL

The defendant, LeRoy J. Leishman, having appealed from the final amended judgment of this court entered on December 18, 1946, to the United States Circuit Court of Appeals for the Ninth Circuit, now tenders to the court the sum of Two Hundred Fifty (\$250.00) Dollars, to be deposited on his behalf with the Clerk of said District Court, subject to the orders of this Court as security that the said appellant shall prosecute his appeal to effect; and that said appellant shall pay all costs if the appeal is dismissed or the judgment affirmed, or of such costs as the Appellate [289] Court may award if the judgment is modified.

Dated at Los Angeles, California, this 17th day of March, 1947.

/s/ LEROY J. LEISHMAN.

[Affidavit of service by mail attached.]

[Endorsed]: Filed March 17, 1947. [290]

[Title of District Court and Cause.]

### NOTICE OF APPEAL

Notice Is Hereby Given that Radio Condenser Company and General Instrument Corporation, plaintiffs above named, appeal to the Circuit Court of Appeals for the Ninth Circuit from so much of the judgment entered in this action on December 18, 1946, as provides that:

“This judgment shall not be construed to mean that the defendant is enjoined from proceeding in the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action No. 2155 of the United States District Court for the Western District of Oklahoma, and defendant is not enjoined from proceeding against Galvin Manufacturing Company.”

LYON & LYON,  
/s/ LEONARD S. LYON,  
/s/ LEONARD S. LYON, JR.,  
Attorneys for Plaintiff.

[Affidavit of service by mail attached.]

[Endorsed]: Filed March 18, 1947. [292]

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[Title of District Court and Cause.]

### COST BOND ON APPEAL

Know All Men by These Presents That:

United States Fidelity and Guaranty Company,  
a corporation organized under the laws of the State



of Maryland, and having an office and place of business at Los Angeles, California, as surety, is held and firmly bound unto LeRoy J. Leishman in the full and just sum of Two Hundred Fifty Dollars (\$250) to be paid to the said LeRoy J. Leishman, his heirs, executors, administrators, successors or assigns, which payment well and truly to be paid the undersigned binds itself by these presents.

Sealed with the seal of the undersigned and dated this 18th day of March, in the Year of our Lord One Thousand Nine Hundred and Forty-seven; and

Whereas, Lately at a District Court of the United States [294] for the Southern District of California, Central Division, in a suit pending in said Court between Radio Condenser Company and General Instrument Corporation, as plaintiffs, and LeRoy J. Leishman, as defendant, a judgment was entered in said suit, and plaintiffs not being satisfied with a part thereof have filed in said Court a Notice of Appeal to reverse the judgment as to said part on appeal to the United States Circuit Court of Appeals for the Ninth Circuit, at a session of said Circuit Court of Appeals to be holden by said court at San Francisco or at Los Angeles in the State of California,

Now, the condition of the above obligation is such that if the said plaintiffs, Radio Condenser Company and General Instrument Corporation, shall make payment of costs if said appeal be dismissed

or the judgment affirmed as to that part of the judgment from which said appeal is taken, or of such costs as the Appellate Court may have against said plaintiffs, then the above obligation to be void, else to remain in full force and effect.

[Seal] UNITED STATES FIDELITY  
AND GUARANTY  
COMPANY,

By /s/ O. D. BRICK,  
Attorney in Fact.

The premium on this bond is \$10.00 for 1 year.

Examined and recommended for approval as provided in Rule 8.

LEONARD S. LYON, JR.,  
Attorneys for Plaintiffs.

I Hereby Approve the foregoing this 18th day of March, 1947.

EDMUND L. SMITH,  
Clerk

By EDW. F. DREW,  
Deputy. [295]

State of California,  
County of Los Angeles—ss.

On this 18th day of March in the year one thousand nine hundred and forty-seven, before me, Elizabeth A. Sheridan, a Notary Public in and for said County and State, residing therein, duly com-

missioned and sworn, personally appeared O. D. Brick, known to me to be the duly authorized Attorney-in-fact of the United States Fidelity and Guaranty Company, and the same person whose name is subscribed to the within instrument as the Attorney-in-fact of said Company and the said O. D. Brick duly acknowledged to me that he subscribed the name of the United States Fidelity and Guaranty Company thereto as Surety and his own name as Attorney-in-fact.

In Witness Whereof, I have hereunto set my hand and affixed my official seal the day and year in this certificate first above written.

[Seal]      /s/ ELIZABETH A. SHERIDAN,  
Notary Public in and for Los Angeles County, State  
of California.

My commission expires Nov. 5, 1948.

[Endorsed]:    Filed March 18, 1947.

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[Title of District Court and Cause.]

STIPULATION AS TO RECORD ON APPEAL  
UNDER RULE 75f R.C.P.

It Is Stipulated by and between the plaintiffs Radio Condenser Company and General Instrument Corporation, through their attorneys, and defendant LeRoy J. Leishman, that the parts of the record, proceedings and evidence, to be included in the record on appeal herein under Rule 75f R.C.P. and transmitted to the Circuit Court of

Appeals for the Ninth Circuit pursuant to Rule 75g R.C.P., shall consist of the following:

1. Complaint and Plaintiffs' Exhibits 1, 2, 3, 4, and A filed therewith.
2. Answer and Counterclaim of defendant filed November 16, 1945.
3. Plaintiffs' Reply to Defendant's Counterclaim.
4. Interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18 served on plaintiffs by defendant December 7, 1945. [296]
5. Plaintiffs' Objections to Defendant's Interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18.
6. Minute Order dated January 18, 1946, sustaining Plaintiffs' Objections to Defendant's Interrogatories.
7. Motion of Plaintiffs for Summary Judgment and Plaintiffs' Exhibits B, C, D, E, F, G and H filed therewith.
8. Affidavit of defendant dated February 15, 1946, in Opposition to Plaintiffs' Motion for Summary Judgment and Defendant's Exhibits E, F, G, H, I, J, K, L, M, N, O, P, Q, 1a, 1b, 2a, 2b, 3a, 3b, 4a, 4b, 5a, 5b, 6, 7, 8, 9a, 9b, 10a, 10b, 11a, 11b, 12a, 12b, 13a, 13b, 14a, 14b, 15a, 15b, and 16a and 16b accompanying the said affidavit.
9. Defendant's Motion to Deny Plaintiffs' Motion for Summary Judgment and Motion to Dis-

miss the Declaratory Judgment Complaint, filed May 25, 1946, and Affidavit of Defendant dated May 25, 1946, filed therewith.

10. Certified Copy of the Findings of Fact, Conclusions of Law and Judgment in the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action No. 2155 in the United States District Court for the Western District of Oklahoma.

11. Defendant's Motion under Rule 15d dated June 21, 1946.

12. Defendant's Second Affidavit dated July 6, 1946, in Support of Motion under Rule 15d and Defendant's First Supplemental Answer and Second Supplemental Counterclaim filed therewith July 8, 1946.

13. Affidavit of Maxwell James dated June 24, 1946.

14. Approved Findings of Fact and Conclusions of Law herein.

15. Judgment.

16. Notice by Clerk of Entry of Judgment September 12, 1946. [297]

17. Writ of Injunction.

18. Order of September 16, 1946, extending time in which to file motion under Rule 52(b).

19. Defendant's Motion under Rule 52b, Affidavit of Defendant dated October 16, 1946, sup-



porting same, and Defendant's Exhibit 17 accompanying same.

20. Court Order of December 18, 1946, denying defendant's motion under Rule 15d, granting in part defendant's motion under Rule 52b, and amending judgment.

21. Notice of Order amending judgment and entry of same December 18, 1946.

22. Notice of Appeal by defendant.

23. Tender of cash deposit in lieu of bond on appeal by defendant dated March 17, 1947.

24. Notice of Appeal by plaintiffs.

25. Cost Bond on Plaintiffs' Appeal.

26. This Stipulation.

It Is Further Stipulated that the costs of certifying the above portions of the record on appeal shall be borne 80% by the defendant LeRoy J. Leishman and 20% by the plaintiffs Radio Condenser Company and General Instrument Corporation.

Dated this 18th day of April, 1947.

LYON & LYON,  
/s/ LEONARD S. LYON,  
/s/ LEONARD S. LYON, JR.,  
Attorneys for Plaintiffs  
Cross-Appellants.

/s/ LEROY J. LEISHMAN,  
Defendant Appellant.

[Endorsed]: Filed April 18, 1947. [298]

[Title of District Court and Cause.]

### CERTIFICATE OF CLERK

I, Edmund L. Smith, Clerk of the District Court of the United States for the Southern District of California, do hereby certify that the foregoing pages numbered from 1 to 301, inclusive, contain full, true and correct copies of Complaint for Declaratory Judgment on Leishman reissue Patent No. Re. 20,827 and exhibits 1, 2, 3, 4 and A thereto; Defendant's Answer and Counter Claim; Plaintiffs' Reply to Defendant's Counterclaim; Interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18 Propounded by Defendant; Plaintiffs' Objections to Defendant's Interrogatories; Minute Order Entered January 18, 1946; Motion of Plaintiffs for Summary Judgment with Exhibits B, C, D, E, F, G and H thereto; Affidavit of LeRoy J. Leishman with all exhibits thereto except Exhibit R; Motion to Deny Plaintiffs' Motion for Summary Judgment and Motion to Dismiss the Declaratory Judgment Complaint; Affidavit of LeRoy J. Leishman; Certified Copies of Findings of Fact and Conclusions of Law and Judgment in Case No. 2155 in the United States District Court for the Western District of Oklahoma; Motion Under Rule 15d; Affidavit of Maxwell James; Second Affidavit of LeRoy J. Leishman in Support of Motion Under Rule 15(d) with Defendant's First Supplemental Answer and Second Supplemental Counterclaim; Findings of Fact and Conclusions of Law; Judgment; Notice of Entry of Judgment; Order of September 16, 1946; Writ of Injunction with Re-

turn of Marshal thereon; Motion Under Rule 52(b) with affidavit of LeRoy J. Leishman and Defendant's Exhibit 17 thereto; Order of December 18, 1946; Notice of Entry of Order; Defendant's Notice of Appeal; Tender of Cash Deposit in Lieu of Bond on Appeal; Plaintiffs' Notice of Appeal; Cost Bond on Appeal; Stipulation as to Record on Appeal; Stipulation and Order Extending Time to file record and docket appeal and Order Extending Time to File Record and Docket Appeal which constitute the record on appeal to the United States Circuit Court of Appeals for the Ninth Circuit.

I further certify that my fees for preparing, comparing, correcting and certifying the foregoing record amount to \$26.70, of which \$5.34 has been paid by Appellees and Cross-Appellants and \$21.36 of which has been paid by Appellant and Cross-Appellee.

Witness my hand and the seal of said District Court this 10th day of June, A.D. 1947.

[Seal]                      EDMUND L. SMITH,  
Clerk.

By /s/ THEODORE HOCKE,  
Chief Deputy Clerk.

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[Endorsed]: No. 11652. United States Circuit Court of Appeals for the Ninth Circuit. LeRoy J. Leishman, Appellant, vs. Radio Condenser Company and General Instrument Corporation, Appellees. Radio Condenser Company and General In-

strument Corporation, Appellants, vs. LeRoy J. Leishman, Appellee. Transcript of Record. Upon Appeals from the District Court of the United States for the Southern District of California, Central Division.

Filed June 13, 1947.

/s/ PAUL P. O'BRIEN,  
Clerk of the United States Circuit Court of Appeals  
for the Ninth Circuit.

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United States Circuit Court of Appeals  
for the Ninth Circuit

No. 11652

LeROY J. LEISHMAN,  
Defendant-Appellant,  
vs.

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,  
Plaintiffs-Appellees and Cross-Appellants.

CONCISE STATEMENT OF POINTS UPON  
WHICH DEFENDANT-APPELLANT, Le-  
ROY J. LEISHMAN, WILL RELY AS RE-  
QUIRED BY RULE 19(6) OF THIS COURT

Pursuant to and in accordance with Rule 19(6)  
of this Court, notice is hereby given that at the  
hearing of this appeal the defendant-appellant will  
rely on the following points:

## I.

That the District Court erred in holding that the plaintiffs have not infringed United States Reissue Letters Patent No. Re. 20,827, particularly claims 7 to 11, inclusive thereof, by the manufacture, use, or sale of condensers and tuners as exemplified by Radio Condenser Company Model 28 tuner, filed with the complaint in this action as Plaintiffs' Exhibit 1, or General Instrument Corporation Model 31 tuner, filed with the complaint in this action as Plaintiffs' Exhibit 3.

## II.

The District Court erred in following the decision of the Ninth Circuit Court of Appeals in the case of *LeRoy J. Leishman v. Associated Wholesale Electric Company*, 137 F. 2d. 722, which was based upon a record vastly different from that in the instant case. It is admitted by both sides that the plaintiffs' tuners are patentwise the same as the Crosley tuner involved in the *Associated* case, in which this Honorable Court correctly held that two of the three elements of the claims were present in the accused devices. As to the third element, this Court held that the operating plungers of the accused radio tuners were not the equivalents of the operating levers shown in the patent. In the *Associated* case, however, there were no prior tuner patents in the record showing the use of plungers as alternatives for levers in operating such devices. But in the instant case, ten such patents have been introduced along with still additional evidence showing that



plungers were known at the date of the patent as proper substitutes for levers in such mechanisms. Having this new and indisputable evidence before it, the District Court should have held that the accused manufacturers had merely omitted one element of the patentee's combination and substituted another that was well known at the date of the patent as a proper substitute for the element withdrawn, and that according to the long-established doctrine laid down in *Seymour v. Osbourne* 78 U. S. 516, 20 L. Ed. 53 and *Imhaeuser v. Buerk*, 101 U. S. 647, 655, 25 L. Ed. 945, infringement had not been avoided.

In the *Associated* case, *supra*, only six prior art patents were in evidence. These were contained in the then appellee-defendant's Exhibit J. Of these six, only the Schaefer, Flaherty and Marschalk patents pertained to automatic tuners, and all three of them were operated by levers. In the new and different evidence in the present record, ten patents are before the court disclosing the prior art use of plungers for operating automatic tuners or for positioning tappets. Three of these ten, Defendant's Exhibits E, O and P, teach the alternative use of levers and plungers for this purpose. Exhibits O and P show the same automatic tuning mechanism operated either by plungers or levers, and Exhibit E shows that it was known in 1883 that levers and plungers could be used alternatively for moving tappets in shaft-positioning devices.

In addition to the ten prior art patents hereinbefore referred to, the defendant submitted pictures as Exhibits 1a to 16b, inclusive, which show

sixteen different well-known prior art mechanisms that are operated either by levers or plungers.

In the face of this indisputable evidence proving that plungers are mechanical equivalents of the levers shown in the patent, it was error for the District Court to follow a former decision of this Appellate Court that was decided upon a different record which contained none of this evidence. The doctrine of *stare decisis* applies only when the record is the same, and it is not to be considered when a more complete record shows the first ruling to be incorrect.

### III.

The District Court erred in granting summary judgment in direct conflict with a previous holding of another U. S. District Court to the effect that the claims here at issue are clearly valid and clearly infringed by the very tuners before this court. Subsequent to the decision of the Ninth Circuit Court of Appeals in the case of *Leishman v. Associated*, *supra*, evidence not before the latter court was presented to the U. S. District Court for the Western District of Oklahoma in the case of *LeRoy J. Leishman v. The Richards and Conover Company*, Civil Action No. 2155, which involved the same accused tuners now before this appellate court. The District Court in Oklahoma held not only that the claims here at issue were clearly valid but that they were clearly infringed by these tuners. In the light of the prior Oklahoma decision, a summary judgment of non-infringement was improper in the instant

case, because a summary judgment is to be granted only when it is very clear that there is no conflict as to any genuine issue of fact. Certainly it cannot summarily be held that there is no genuine issue of fact in opposition to plaintiffs' allegation of non-infringement when another U. S. District Court after a full trial has just previously held that the same claims here at issue are clearly infringed by the same tuners involved in the summary judgment proceedings.

#### IV.

The District Court erred in sustaining plaintiffs' objections to defendant's interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18, requiring data on the volume of plaintiffs' sales to show the extent of plaintiffs' commercial success. It has repeatedly been held by this appellate court that great commercial success is an important factor in determining the question of invention, and it has been held by other courts, including the Supreme Court, that the commercial success of an infringer is as much to be considered as the commercial success of the patentee. The data sought was thus highly pertinent and was peculiarly within the knowledge of the plaintiffs.

#### V.

The District Court erred in denying defendant's request for permission to file a supplemental answer to the complaint, which said supplemental answer alleged that the plaintiffs in this action were bound by the decision in the case of *Leishman v. The Rich-*

ards and Conover Company, *supra*, for the reason that the said plaintiffs participated in the defense of that suit. The law in this circuit and elsewhere is that a party not a stranger to the action who aids or participates in the defense of such action in the furtherance of some interest of his own, is bound by the decision in such suit.

In the instant case, the plaintiffs had long anticipated that their tuners would be accused as infringements of the patent here at issue, and a legal defense was decided upon long before the defendant herein had accused these tuners in the suit against The Richards and Conover Company. Moreover, before that action was commenced, special models were built by the plaintiffs herein to demonstrate that pre-arranged defense. The affidavit of plaintiffs' patent counsel, Maxwell James, recounts the building of these models and explains the defense that they were to demonstrate. Mr. James also sets forth in his affidavit that he received a long distance telephone call from Foorman L. Mueller, counsel for the Richards and Conover Company, stating that he, Mueller, was not fully prepared for trial, and calling upon Mr. James for help. Mr. James' affidavit states that he sent Mr. Mueller the specially prepared models which he describes elsewhere in the affidavit as a "model of the Marschalk patent and another model showing how the lever device of the Schaefer patent could be substituted for the lever device of the Marschalk patent, to demonstrate that there was no invention in so doing." The transcript of pertinent portions of the record of The



Richards and Conover suit, Defendant's Exhibit 17, shows that Mr. Mueller, who admitted that he was not prepared, adopted the defense that had been prepared by the plaintiffs in the present action, and that the whole defense in the Oklahoma action consisted in laying the ground work for the introduction of these models and in demonstrating them to the court. The present plaintiffs thus not only aided or participated in the defense of the Oklahoma action, which alone would have been enough to bind them, but they actually controlled the defense of the suit by responding to Mr. Mueller's request and presenting him with a ready-made defense.

Inasmuch as the facts detailed in the foregoing paragraphs were established by photostats of the transcript of the Oklahoma trial and by the James affidavit submitted by the plaintiffs, the District Court should have permitted the filing of a supplemental answer to the complaint, setting up the defense that the plaintiffs were bound by participation in the Oklahoma action; and the District Court erred in denying the motion requesting such permission.

## VI.

The District Court erred in failing to hold that the plaintiffs herein were bound by the decision of the U. S. District Court for the Western District of Oklahoma in the case of *Leishman v. The Richards and Conover Company*. Had the lower court so held in accordance with the facts set forth in section V hereof, it would have been unnecessary to have considered any of the other issues.



## VII.

The District Court erred in denying any part of Defendant's Motion under Rule 52(b). This motion pointed out the errors in the Findings of Fact, Conclusions of Law, and Judgment; and it proposed a different set of findings and legal conclusions and a judgment in accordance with the facts hereinbefore discussed.

Wherefore the defendant-appellant prays that the summary judgment of the District Court be reversed and that this Honorable Court hold (a) that the plungers of the plaintiffs' tuners are the equivalents of the operating levers shown in the patent; (b) that claims 7, 8, 9, 10 and 11 of the patent here in suit are infringed by the plaintiffs' tuners; (c) that defendant-appellant's proposed second supplemental amendment should be admitted; (d) that the plaintiffs-appellees and cross-appellants cannot be heard to challenge the validity of the patent for the reason that the plaintiffs are bound by the decision in the case of *Leishman v. The Richards and Conover Company*, Civil action 2155, in the U. S. District Court for the Western District of Oklahoma, because of the participation of the present plaintiffs therein; and (e) that a summary judgment should not have been granted under the circumstances.

/s/ LeROY J. LEISHMAN,  
Defendant-Appellant in  
propria persona.

It is hereby certified that a copy of this document is being mailed to counsel for the plaintiffs-appellees and cross-appellants at 811 West Seventh St., Los Angeles 14, California, simultaneous with the mailing of the originals and copies thereof to the clerk of the U. S. Circuit Court of Appeals for the Ninth Circuit.

/s/ LeROY J. LEISHMAN,  
Defendant-Appellant in  
propria persona

Dated, Los Angeles, California, June 23, 1947.

[Endorsed]: Filed June 24, 1947.

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[Title of Circuit Court of Appeals and Cause.]

STIPULATION FOR DESIGNATION ON AP-  
PEAL UNDER RULE 19(6) OF THIS  
COURT

It Is Stipulated by and between the Radio Condenser Company and General Instrument Corporation, plaintiffs-appellees and cross-appellants, through their attorneys, and the defendant-appellant, LeRoy J. Leishman, that the following shall constitute the designated parts of the record, exclusive of physical exhibits, which shall be printed by the Clerk from the records, proceedings and evidence contained in the record on appeal transmitted by the Clerk of the United States District Court for the Southern District of California, pursuant to the

stipulation dated April 18, 1947, and shall constitute the printed record on appeal herein.

1. Complaint and Plaintiffs' Exhibits 1, 3 and A filed therewith.

2. Answer and Counterclaim of defendant filed November 16, 1945.

3. Plaintiffs' Reply to Defendant's Counterclaim.

4. Interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18 served on plaintiffs by defendant December 7, 1945.

5. Plaintiffs' Objections to Defendant's Interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18.

6. Minute Order dated January 18, 1946, sustaining Plaintiffs' Objections to Defendant's Interrogatories.

7. Motion of Plaintiffs for Summary Judgment and Plaintiffs' Exhibits B, C, D, E, and G filed therewith.

8. Affidavit of defendant dated February 15, 1946, in Opposition to Plaintiffs' Motion for Summary Judgment.

9. Defendant's Motion to Deny Plaintiffs' Motion for Summary Judgment and Motion to Dismiss the Declaratory Judgment Complaint, filed May 25, 1946, and Affidavit of Defendant dated May 25, 1946, filed therewith.

10. Certified Copy of the Findings of Fact, Conclusions of Law and Judgment in the case of LeRoy

J. Leishman v. The Richards and Conover Company, Civil Action No. 2155 in the United States District Court for the Western District of Oklahoma.

11. Defendant's Motion under Rule 15d dated June 21, 1946.

12. Defendant's Second Affidavit dated July 6, 1946, in Support of Motion under Rule 15d and Defendant's First Supplemental Answer and Second Supplemental Counterclaim filed therewith July 8, 1946.

13. Affidavit of Maxwell James dated June 24, 1946.

14. Approved Findings of Fact and Conclusions of Law herein.

15. Judgment.

16. Notice by Clerk of Entry of Judgment September 12, 1946.

17. Writ of Injunction.

18. Order of September 16, 1946, extending time in which to file motion under Rule 52(b).

19. Defendant's Motion under Rule 52b, Affidavit of Defendant dated October 16, 1946, supporting same, and Defendant's Exhibit 17 accompanying same.

20. Court Order of December 18, 1946, denying defendant's motion under Rule 15d, granting in part defendant's motion under Rule 52b, and amending judgment.

21. Notice of Order amending judgment and entry of same December 18, 1946.

22. Notice of Appeal by defendant.

23. Tender of cash deposit in lieu of bond on appeal by defendant dated March 17, 1947.

24. Notice of Appeal by plaintiffs.

25. Cost Bond on Plaintiffs' Appeal.

26. Stipulation as to Record on Appeal under Rule 75f F.R.C.P.

27. This Stipulation.

28. Stipulation and Order designating certain of plaintiffs' and defendant's exhibits as physical exhibits on appeal.

29. Concise Statement of Points Upon Which Defendant-Appellant, LeRoy J. Leishman, Will Rely as Required by Rule 19(6) of this Court.

30. Concise Statement of Points Upon Which Plaintiffs-Appellees and Cross-Appellants, Radio Condenser Company and General Instrument Corporation, Will Rely as Required by Rule 19(6) of this Court.

It is further stipulated that the Clerk of the Court shall cause to be printed sixteen (16) copies of a Book of Exhibits which shall contain the following parts of the record and evidence:

1. U. S. Reissue Patent No. Re. 20,827, which formed a part of the file wrapper designated Plain-



tiffs' Exhibit F, filed with Plaintiffs' Motion for Summary Judgment.

2. Original U. S. Patent No. 2,108,538, which was filed as Plaintiffs' Exhibit H with Plaintiffs' Motion for Summary Judgment.

3. The following exhibits filed with Defendant's Affidavit in Opposition to Plaintiffs' Motion for Summary Judgment:

Defendant's Exhibit E, U. S. Patent No. 290,894 to Kettell.

Defendant's Exhibit F, U. S. Patent No. 1,687,420 to Bast.

Defendant's Exhibit G, U. S. Patent No. 1,704,754 to Marvin.

Defendant's Exhibit I, British Patent No. 405,716 to Freytag.

Defendant's Exhibit J, U. S. Patent No. 703,570 to Gerdes.

Defendant's Exhibit K, U. S. Patent No. 1,928,200 to Fass.

Defendant's Exhibit L, Certified translation of German Patent No. 438,696.

Defendant's Exhibit M, photostat of German Patent No. 438,696.

Defendant's Exhibit N, U. S. Patent No. 2,297,152 to Jacke.

Defendant's Exhibit O, U. S. Patent No. 1,865,704 to Peck.

Defendant's Exhibit P, Certified translation of Danish Patent No. 52,047.

Defendant's Exhibit Q, photostatic copy of Danish Patent No. 52,047.

Two copies of the Book of Exhibits shall be supplied to Defendant-Appellant, four copies to counsel for the Plaintiffs-Appellants, Radio Condenser Company and General Instrument Corporation, and the remainder are to be retained by the Clerk of this court to form a part of the record on appeal.

It is further stipulated that the costs of printing the record herein and of printing the Book of Exhibits shall be paid eighty per cent (80%) by defendant-appellant, LeRoy J. Leishman, and twenty per cent (20%) by plaintiffs-appellees and cross-appellants, Radio Condenser Company and General Instrument Corporation.

Dated this 27th day of June, 1947.

/s/ LeROY J. LEISHMAN,  
Defendant-Appellant in  
propria persona.

/s/ LEONARD S. LYON,  
/s/ LEONARD S. LYON, JR.,  
Attorneys for Plaintiffs-Appellees and Cross-Appellants.

It is so ordered this .... day of ....., 1947.

[Endorsed]: Filed July 1, 1947.

[Title of Circuit Court of Appeals and Cause.]

CONCISE STATEMENT UNDER RULE 19 OF  
THIS COURT OF THE POINTS UPON  
WHICH RADIO CONDENSER COMPANY  
AND GENERAL INSTRUMENT CORPO-  
RATION RELY UPON APPEAL IN THE  
ABOVE-ENTITLED CAUSE

1. The court erred in granting defendant's motion under Rule 52(b) of the Federal Rules of Civil Procedure and amending the judgment in this cause by the addition of the seventh paragraph thereof, reading:

“This judgment shall not be construed to mean that the defendant is enjoined from proceeding in the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action No. 2155 in the United States District Court for the Western District of Oklahoma, and defendant is not enjoined from proceeding against Galvin Manufacturing Company.”

2. The court erred in excluding from the injunction ordered in this cause the prosecution by defendant of the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action 2155 in the United States District Court for the Western District of Oklahoma, in failing to enjoin the further prosecution by defendant of that cause, and in excluding from the said injunction the Galvin Manufacturing Company.

3. By excluding from the injunction ordered in this cause the Galvin Manufacturing Company and the further prosecution of the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action 2155 in the United States District Court for the Western District of Oklahoma, the court erred, in failing fully to effectuate its decree of non-infringement in this cause by an injunction protecting plaintiffs' right to continue the business of manufacturing and selling their tuners as exemplified by Radio Condenser Company Model 28 Tuner or General Instrument Corporation Model 31 Tuner, throughout the United States without molestation by the defendant through his patent Reissue Letters Patent No. Re. 20,827.

4. By excluding from the injunction ordered in this cause the Galvin Manufacturing Company and the further prosecution of the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action 2155 in the United States District Court for the Western District of Oklahoma, the court erred, in failing fully to effectuate its decree of non-infringement in this cause by an injunction restricting the further prosecution of suits under Reissue Letters Patent Re. 20,827 against any customer of plaintiffs' for alleged infringement of defendant's Reissue Letters Patent Re. 20,827 by using or selling tuners manufactured by plaintiffs

as exemplified by Radio Condenser Company Model  
28 Tuner of General Instrument Corporation Model  
31 Tuner.

Dated this 30th day of June, 1947.

/s/ LEONARD S. LYON,

/s/ LEONARD S. LYON, JR.,

Attorneys for Plaintiffs-Appellees and Cross-Appellants.

[Affidavit of service by mail attached.]

[Endorsed]: Filed July 2, 1947.



At a Stated Term, to wit: The October Term 1946, of the United States Circuit Court of Appeals for the Ninth Circuit, held in the Court Room thereof, in the City and County of San Francisco, in the State of California, on Monday, the seventh day of July, in the year of our Lord one thousand nine hundred and forty-seven.

Present: Honorable Francis A. Garrecht,  
Senior Circuit Judge, Presiding.  
Honorable William Healy, Circuit Judge.  
Honorable William E. Orr, Circuit Judge.

No. 11652

LeROY J. LEISHMAN,

Appellant,

vs.

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,

Appellees,

and

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,

Appellants,

vs.

LeROY J. LEISHMAN,

Appellee.

ORDER EXTENDING TIME TO FILE  
TRANSCRIPT OF RECORD

Upon consideration of the motions of counsel for the respective parties, and good cause therefor appearing, It Is Ordered that the time within which the certified transcript of record may be filed and the cause docketed in this court be, and hereby is extended to and including June 13, 1947.

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United States Circuit Court of Appeals  
for the Ninth Circuit

No. 11652

LeROY J. LEISHMAN,  
Defendant-Appellant,  
vs.

RADIO CONDENSER COMPANY and GEN-  
ERAL INSTRUMENT CORPORATION,  
Plaintiffs-Appellees and Cross-Appellants.

STIPULATION AND ORDER DESIGNATING  
CERTAIN DOCUMENTARY EXHIBITS  
TO BE PHYSICAL EXHIBITS FOR THE  
RECORD ON APPEAL

It Is Stipulated by and between the Radio Condenser Company and General Instrument Corporation, plaintiffs-appellees and cross-appellants, through their attorneys, and the defendant-appellant, LeRoy J. Leishman, that the following docu-

mentary exhibits, because of the cost of reproduction in the printed record, need not be printed, but shall constitute physical exhibits and be a part of the record on appeal: Plaintiffs' Exhibit F, which is the file wrapper of U. S. Patent No. Re. 20,827, and Defendant's Exhibits 1a, 1b, 2a, 2b, 3a, 3b, 4a, 4b, 5a, 5b, 6, 7, 8, 9a, 9b, 10a, 10b, 11a, 11b, 12a, 12b, 13a, 13b, 14a, 14b, 15a, 15b, 16a and 16b, the said Defendant's Exhibits to be attached together as one document; and all of these exhibits may be used and considered by the Court and counsel for all purposes upon said appeal.

/s/ LeROY J. LEISHMAN,  
Defendant-Appellant,  
in propria persona.

/s/ LEONARD S. LYON,  
/s/ LEONARD S. LYON, JR.,  
Counsel for Plaintiffs-Appellees and Cross-Appellants.

It is so ordered this 12th day of August, 1947.

/s/ FRANCIS A. GARRECHT,  
Senior U. S. Circuit Judge.

[Endorsed]: Filed Aug. 12, 1947.